

***United States Court of Appeals  
for the  
District of Columbia Circuit***



**TRANSCRIPT OF  
RECORD**



TRANSCRIPT OF RECORD.

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Court of Appeals, District of Columbia

OCTOBER TERM, 1900.

No. 1031.

No. 11, SPECIAL CALENDAR.

48

THE UNITED STATES OF AMERICA ON THE RELATION  
OF THE BRONSON COMPANY, ADELBERT E. BRONSON,  
JR., VICTORIA BRONSON, AND THOMAS C. WILLARD,  
APPELLANTS,

*vs.*

CHARLES H. DUELL, COMMISSIONER OF PATENTS.

APPEAL FROM THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

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FILED NOVEMBER 13, 1900.

# COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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# In the Court of Appeals of the District of Columbia.

THE U. S. OF AMERICA on the Relation of the Bronson  
Company *et al.*, Appellants,  
*vs.*  
CHARLES H. DUELL, Commissioner of Patents. } No. 1031.

*a* Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the  
Relation of The Bronson Company *et al.* } No. 43585. At Law.  
*vs.*  
CHARLES H. DUELL, Commissioner of Patents. }

UNITED STATES OF AMERICA, } *ss* :  
*District of Columbia,* }

Be it remembered that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had in the above-entitled cause, to wit:

1 *Petition for Mandamus.*  
Filed Jan. 3, 1900.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the  
Relation of The Bronson Company, Adel-  
bert E. Bronson, Jr., Victoria Bronson, and  
Thomas C. Willard, Relators,  
*vs.*  
CHARLES H. DUELL, Commissioner of Patents,  
Respondent. } At Law. No. 43585.

The above-named relators respectfully show to the court that they are citizens of the United States, residing at Cleveland, in the State of Ohio; that the respondent, Charles H. Duell, is the Commissioner of Patents, duly qualified and acting as such, and that the said respondent was such Commissioner and acting as such at the time of the occurrences hereinafter mentioned, and still is such Commissioner.

Your relators further say that heretofore, to wit, on the 7th day of December, 1898, they filed in the United States Patent Office an application for the registration of their lawful trade-mark, consisting of the compound word or phrase "ever-ready," to be applied to coffee mills.

2 Your relators further say that heretofore and subsequent to the date of filing of the said application the examiner of trade-marks rejected the said application on the ground that the mark is descriptive.

Your relators further say that heretofore and subsequent to the date of filing of the said application, to wit, on the 6th day of April, 1899, an appeal was taken from the action of the said examiner to the Commissioner of Patents.

Your relators further say that heretofore, to wit, on the 18th day of May, 1899, the Commissioner of Patents refused registration of the said mark on the ground that it is not a trade-mark.

All of which will more fully and at length appear and be shown in the transcript of record and exhibits to accompany this petition.

Your relators charge that the said Commissioner of Patents had no right or authority to refuse registration of their lawful trade-mark; that there is no power in the said respondent, the Commissioner of Patents, under the statutes of the United States providing for the registration of trade-marks, to refuse to register a trade-mark for any reason not specifically and precisely defined in the above-mentioned statutes, and that the said Commissioner of Patents had no authority under the said statutes to refuse registration upon the ground that the said mark is descriptive, or upon the ground that the said mark is not a trade-mark as defined by the said Commissioner of Patents in his said decision of May 18, 1899, and that in respect to these matters the function of the Commissioner of Patents is ministerial and not judicial, and that by the said rejections  
3 of the said trade-mark the Commissioner of Patents has exceeded the authority reposed in him by the said statutes.

Your relators further charge that they have no relief in the premises save by a writ of mandamus, and that, as they are advised by counsel, a writ of error will not lie from the action of the said respondent to any superior tribunal.

Further, your relators charge that the action of the said respondent in the premises is a matter of public concern.

And your relators therefore pray that this honorable court will by its writ of mandamus command the said respondent, The Commissioner of Patents, as aforesaid, to set aside the said rejections or refusals to register, and to register the said mark.

THE BRONSON CO.,  
By ADELBERT E. BRONSON, JR.

STATE OF OHIO, }  
County of Cuyahoga, } ss :

I, Adelbert E. Bronson, Jr., do solemnly swear that I am a member of the above-mentioned firm of The Bronson Company; that I have read the foregoing relation and petition by me signed for said firm, and that I know the contents thereof; that the matters therein stated of my own knowledge are true, and that those therein stated upon information and belief I believe to be true.

ADELBERT E. BRONSON, JR.

Subscribed and sworn to before me this 23rd day of December, 1899.

[Notarial Seal, Cuyahoga County, Ohio.]

ALBERT H. BATES,  
*Notary Public.*

4

*Order to Show Cause.*

Filed Jan. 3, 1900.

In the Supreme Court of the District of Columbia, this 3rd Day of January, 1900.

THE UNITED STATES OF AMERICA on the Relation of The Bronson Company, Adelbert E. Bronson, Jr., Victoria Bronson, and Thomas C. Willard, Relators,	} At Law. No. 43585.
<i>vs.</i>	
CHARLES H. DUELL, Commissioner of Patents, Respondent.	

Upon reading the petition for writ of mandamus in the above-entitled cause, and upon consideration of the same, this 3rd day of January, 1900, it is ordered that the respondent appear before this court on the 8th day of January, 1900, at 10 o'clock a. m., to show cause, if any he can, why the said writ of mandamus should not issue as prayed for by the said relators, and that a copy of this order be served upon the said respondent.

By the court:

CHAS. C. COLE,  
*Asso. Justice.*

*Memorandum.*

Served respondent Jan'y 4, 1900.

AULICK PALMER, *Marshal.*

5

*Demurrer to the Petition.*

Filed Jan. 8, 1900.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the Relation of The Bronson Company, Adelbert E. Bronson, Jr., Victoria Bronson, and Thomas C. Willard, Relators,	} At Law. No. 43585.
<i>vs.</i>	
CHARLES H. DUELL, Commissioner of Patents of the United States, Respondent.	

Demurrer to the petition.

The respondent says that the petition is bad in substance.

W. A. MEGRATH,  
*Attorney for Respondent.*

The respondent notes the following matters to be argued in particular, to wit:

First. The trade-mark law approved March 3, 1881, under which petitioners' application for the registration of a trade-mark was filed, makes the Commissioner of Patents the sole and final judge as to the presumptive lawfulness of claims to the alleged trade-mark, and this court cannot interfere by mandamus to direct, control, or command his judgment therein.

Second. Another matter to be argued is that under the law referred to the duty of the respondent, The Commissioner of Patents, in deciding the presumptive lawfulness of claim to an alleged trade-mark on an application for registration is wholly discretionary and not ministerial, and the petition showing that such discretionary duty has been performed by such respondent, mandamus will not lie.

Third. Another matter is that the trade-mark law referred to makes the decision of the Commissioner of Patents as to the presumptive lawfulness of a claim to an alleged trade-mark final and conclusive, and therefore a command of this court requiring the Commissioner of Patents to register such a mark on an application therefor after an adverse decision thereon by the Commissioner would be, in purpose and effect, to overrule and supplant the decision of the Commissioner in such matter and to substitute therefor the decision of this court as to the presumptive lawfulness of claim to such a mark—a result not contemplated nor provided for by the trade-mark act, but, on the contrary, prohibited by the plain wording and meaning thereof.

Fourth. Another matter is that, it appearing affirmatively from the petition of the relators that the respondent, Charles H. Duell, Commissioner of Patents, has as a matter of fact, in accordance with his judgment in and under the trade-mark law, decided against the presumptive lawfulness of claim to the alleged trade-mark "ever-ready," as applied to coffee mills, on the application for registration of such mark by the relators, this honorable court has no jurisdiction to command the respondent to register the said words for the relators as a trade-mark, nor to require the respondent to show cause why he has not registered and still refuses to register said mark upon the application of the relators.

Fifth. Another matter is that the petition shows, not that the respondent has refused and continues to refuse to perform a discretionary duty, to wit, to pass upon the presumptive lawfulness of the alleged trade-mark of the relators and decide whether such trade-mark should be registered in the United States Patent Office, as required of him under and by virtue of the trade-mark law, but, on the contrary, the petition shows that the respondent has decided the presumptive lawfulness of claim to the alleged trade-mark and decided it adversely to the relators, and that the respondent has declined and continues to decline to decide that said trade-mark should be registered to the relators upon their application as filed, and also refuses to decide it in favor of the relators in accordance

with certain constructions put upon the trade-mark law by the relators, as set forth and referred to in their petition.

W. A. MEGRATH,  
*Attorney for Respondent.*

8

*Stipulation.*

Filed Jan. 27, 1900.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the Re- lation of The Bronson Company, Adelbert E. Bronson, Jr., Victoria Bronson, and Thomas C. Willard, Relators,	} At Law. No. 43585.
CHARLES H. DUELL, Commissioner of Pat- ents, Respondent.	

*vs.*

*Stipulation.*

It is hereby stipulated by the counsel for the relator- and the counsel for the respondent that the attached extract from the statement of the Bronson Company, the copy of the examiner's statement, and the printed copy of the Commissioner's decision may constitute the record in the above-entitled cause.

WALTER F. ROGERS,  
*For the Relator-.*

W. A. MEGRATH,  
*For the Respondent.*

January 26, 1900.

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EXHIBITS.

\* \* \* \* \*

Our trade-mark consists of the hyphenated word ever-ready.

This has generally been arranged as shown in the accompanying fac-simile, in which it appears in plain block capitals, printed in black in a curved line, and enclosed by quotation-marks, but any other form of type may be employed, or it may be differently arranged or colored, and the quotation-marks may be omitted without materially altering the character of our trade-mark, the essential feature of which is the hyphenated word ever-ready.

This trade-mark has been used by us continuously in business since April 1st, 1898.

The class of merchandise to which this trade-mark is appropriated is coffee mills, and the particular description of goods comprised in such class on which it is used by us is domestic coffee mills—that is, small coffee mills for family use. It has been our practice to mark our trade-mark on the outside of a canister, which is secured above and serves as a hopper for the coffee mill.

\* \* \* \* \*

Filed Jan. 27, 1900.

United States Patent Office.

Application of The Bronson Company. Trade-mark. Filed December 7, 1898. Serial number, 57201.

Before the Commissioner, on appeal.

Attorneys: Thurston & Bates, Cleveland, Ohio.

Associate: Walter F. Rogers, Washington, D. C.

*Examiner's Statement.*

Applicant appeals from the action of the examiner in refusing to register the hyphenated word "ever-ready" as a trade-mark for domestic coffee mills.

The ground of refusal is that the words, as applied to the class of goods named, are indicative of a quality of goods, and do not in any manner indicate the origin or ownership thereof.

The decisions cited are—

*Ex parte* Safety Powder Co., C. D. 1879, 117 ;

" " Brigham, C. D. 1881, 38 ;

" " Christiansen, 53 MS. D., 368 ;

" " Yung, 57 MS. D., 479 ;

" " Success Remedy Company, 58 MS. D., 353 ;

" " Hance Brothers & White, 66 MS. D., 374, and

" " Crusius Brothers, 82 O. G., 1687.

The Supreme Court in *Columbia Mill Company v. Alcorn*,  
11 65 O. G., 1916, held as follows:

"(2.) That if the device, mark, or symbol was adopted or placed upon the article for the purpose of identifying its class, grade, style, or quality or for any purpose other than a reference to or indication of its ownership, it cannot be sustained as a valid trade-mark."

It is believed that the words "ever ready," as applied to coffee mills, indicate that the mills are always ready for use or, in other words, "ever ready" for use. These words would therefore seem to indicate a quality of the mills, and to this extent they are descriptive and not indicative of origin or ownership.

The decisions in *Safety Powder Co.*, wherein the word "safety," as applied to powder, was held to be descriptive; *Brigham*, refusing "satin polish" for shoe polish; *Christiansen*, refusing "surefit" for patterns; *Yung*, refusing "common sense" for weather strips; *Success Remedy Co.*, refusing "success" for a medical compound, and *Hance Brothers & White*, refusing "chill stop" for a medicine, are all to the effect that words which are used "as an advertisement of some desirable quality of the goods themselves" are not registrable as trade-marks. The words "ever ready," as applied to coffee mills, are believed to be such an advertisement of a quality of the goods to which they are applied as to inhibit their registration.

The hyphenating of the words does not appear to lend arbitrary

character thereto, in view of the ruling of the Commissioner in *Ex parte* Pittsburg Pump Company, 84 O. G., 309.

Respectfully submitted.

\_\_\_\_\_,  
*Examiner, Division 33.*

April 10, 1899.

Patent Office.

U. Apr. 10, 1899. S.

Mailed.

12

(Filed Jan. 27, 1900.)

*Ex Parte* The BRONSON COMPANY.

Decided May 18, 1899.

1. Trade-mark—"Ever-ready"—Coffee mill.—Tested by the definitions given to the term "trade-mark" and applying the rules laid down as guides, it is *held* that the term "ever-ready," plainly meaning *always ready*, as applied to a domestic coffee mill intended for ordinary and daily household use is not a trade-mark, in that it lacks the essential characteristics of individuality and exclusiveness.
2. Same—Construction of act of March 3, 1881—"Owners of trade-marks."—The phrase "owners of trade-marks" appearing in the act of March 3, 1881, manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trade-mark.
3. Same—Same—Questions to be decided by Patent Office tribunals.—It is incumbent upon the various tribunals of the Patent Office having in charge the registration of trade-marks when an application for registration is filed to decide at the outset two questions: (1) Is applicant the owner, and (2) is that which he seeks to register a trade-mark?
4. Same—Same—Tribunals not precluded by statements of applicant—Ownership.—The tribunals of the Patent Office in deciding the question of ownership are not precluded by the statement and declaration of ownership made by the applicant from considering and deciding whether he is or is not the owner of the thing sought to be registered.
5. Same—Same—Same—True "trade-mark."—It is the province and duty of the tribunals of the Patent Office having jurisdiction of the registration of trade-marks to decide whether the thing presented for registration is a trade-mark. An applicant may be the owner of the thing alleged to be his trade-mark, and yet the thing presented for registration may not be a trade-mark. The statement and declaration of applicant that the thing presented for registration is a trade-mark are not conclusive.

On appeal.

*Trade-mark for Coffee Mills.*

Application for registration filed December 7, 1898, No. 57201.

Messrs. Thurston & Bates and Mr. W. F. Rogers for the applicant.

DUELL, *Commissioner* :

From the examiner's action in refusing to register the hyphenated word "ever-ready" as a trade-mark for domestic coffee mills the applicant has taken this appeal.

Under the statute of March 3, 1881, "owners of trade-marks," under certain conditions as to use and upon compliance with certain requirements which need not now be considered, are entitled to obtain registration therefor. The phrase "owners of trade-marks" manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trade-mark. It is therefore incumbent upon the various tribunals of the office having in charge the registration of trade-marks when an application for registration is filed to decide at the outset two questions: (1) Is applicant the *owner*, and (2) is that which he seeks to register a *trade-mark*? Manifestly the tribunals of this office in deciding the question of ownership are not precluded by the statement and declaration of ownership made by the applicant from considering and deciding whether he is or is not the *owner* of the thing sought to be registered. It is not unusual to refuse registration because of the absence of legal title in the applicant—for example, when it appears that before applicant adopted and used his alleged mark the identical thing had been adopted and used by another. Equally is it the province and duty of the tribunals of the office having jurisdiction of the registration of trade-marks to decide whether the *thing* presented for registration is a *trade-mark*. An applicant may be the owner of the thing alleged to be his trade-mark, and yet the thing presented for registration may not be a trade-mark. The statement and declaration of applicant that the thing presented for registration is a trade-mark are not conclusive. The question is what the thing *is*, and not what it is *called*. That the statute vests in this office the power to pass upon these two questions I believe, and to pass upon such questions has been the uniform practice of my predecessors ever since the enactment of the trade-mark law of 1881.

The question for decision in this case is whether the hyphenated word "ever-ready" is a trade-mark. A word not otherwise a trade-mark cannot be made so by being hyphenated. (*Ex parte Pittsburgh Pump Co.*, 84 O. G., 309.)

This leaves for decision the question whether the term "ever-ready" applied to a domestic coffee mill is a trade-mark. A trade-mark has been variously defined. Of it has been said:

There are certain infallible indicia of the nature of the symbol known to commerce and jurisprudence as a trade-mark. These are:

1. *Invariability*, *i. e.* fixed, positive, unmistakable; 2. *Individuality*, such a difference from other symbols as to indicate origin and ownership; 3. *Universality* of a right to its use, *i. e.* good as a representative of, or substitute for, the owner's signature all the world over; 4. *Exclusiveness* of the right to use; 5. *Application to merchandise*; 6. *Use in lawful business*; 7. *Truth and good faith*; 8. *Duration unlimited* but by the trade itself. (Browne on Trade-marks, sec. 143, p. 162.)

The Century Dictionary thus defines a trade-mark:

A distinguishing mark or device adopted by a manufacturer and impressed on his goods, labels, etc., to indicate the origin or manufacturer.

The United States Supreme Court in *Columbia Mill Co. v. Alcorn et al.* (65 O. G., 1916; 150 U. S., 460) has substantially defined a trade-mark as a name, device, or symbol which points distinctively, either by itself or by association, to the origin, manufacture, or ownership of the article on which it is stamped. Repeatedly the courts, by the process of exclusion, have defined the term. Examples are numerous. The Supreme Court in its first trade-mark case said:

Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as trade-mark. (*Canal Co. v. Clark*, 1 O. G., 279; 13 Wall., 311.)

Also:

Yet if the device or symbol was not adopted for the purpose of indicating origin, manufacture, or ownership, but was placed upon the article to denote class, grade, style, or quality, it cannot be upheld as technically a trade-mark. (*Lawrence Mfg. Co. v. Tenn. Mfg. Co.*, 55 O. G., 1528; 138 U. S., 537.)

Again:

Words which are merely descriptive of the character, qualities, or composition of an article or of the place where it is manufactured or produced, cannot be monopolized as a trade-mark. (*Brown Chemical Co. v. Meyer*, 55 O. G., 287; 139 U. S., 540.)

The circuit court of appeals for the second circuit has said:

No principle of the law of trade-marks is more familiar than that which denies protection to any word or name which is descriptive of the qualities, ingredients, or characteristics of the article to which it is applied. An exclusive right to the use of such a word, as a trade-mark, when applied to a particular article or class of articles, cannot be acquired by the prior appropriation of it, because all persons who are entitled to produce and vend similar articles are entitled to describe them, and to employ any appropriate terms for that purpose. (*Bennett et al. v. McKinley et al.*, 65 Fed. Rep., 505.)

In the same case the court recognized the fact that a word may be fanciful when applied to one article and descriptive when applied to another, saying:

Whether a word claimed as a trade-mark is available because it is a fanciful or arbitrary name, or whether it is obnoxious to the ob-

jection of being descriptive, must depend upon the circumstances of each case. The word which would be fanciful or arbitrary when applied to one article may be descriptive when applied to another. If it is so apt, and legitimately significant of some quality of the article to which it is sought to be applied, that its exclusive concession to one person would tend to restrict others from properly describing their own similar articles, it cannot be the subject of a monopoly.

In that case the court held that the word "instantaneous" when applied to tapioca, which rendered unnecessary the preliminary soaking required by other tapioca preparations, was not capable of being monopolized as a trade-mark. The language of the court in its decision aptly applies to the case at bar, and if specific authority be required for the conclusion reached it is there found.

The circuit court of appeals for the sixth circuit in a very recent case said :

It sometimes happens that the labels or characteristic marks which manufacturers use upon their goods are catch-words designed to attract purchasers, and to inspire the belief that theirs excel all others in merit, or that in popular estimation they are of superior quality. It will not do to say that any one manufacturer may exclude all others from the use of labels or marks which, differing in terms and characteristics, are honestly designed and used to obtain the same advantages. In other words, one cannot make an exclusive appropriation of words or marks which he puts upon his goods, and which simply indicate their superiority or popularity, or universality in use, and no more. (*Proctor & Gamble Co. v. Globe Refining Co.*, 92 Fed. Rep., 357.)

Tested by the definitions given to the term "trade-mark" and applying the rules laid down as guides, it must be held that the term "ever-ready," plainly meaning *always ready*, as applied to a domestic coffee mill intended for ordinary and daily household use, is not a trade-mark, in that it lacks the essential characteristics of "individuality" and "exclusiveness."

The decision of the examiner of trade-marks is affirmed.

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*Order Sustaining Demurrer, &c.*

Filed Nov. 5, 1900.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the Re-  
lation of The Bronson Company, Adelbert  
E. Bronson, Jr., Victoria Bronson, and  
Thomas C. Willard, Relators,

vs.

CHARLES H. DUELL, Commissioner of Pat-  
ents, Respondent.

At Law. No. 43585.

This cause coming on to be heard upon the petition for a writ of mandamus, the rule to show cause, and the demurrer of respondent

filed herein, and after hearing counsel for the respective parties hereto, it is ordered that the demurrer be, and the same is hereby, sustained; that the rule to show cause be discharged, and that the petition be, and the same is, dismissed at the costs of the relator.

CHAS. C. COLE,  
*Associate Justice.*

14 *Appeal.*

Filed Nov. 6, 1900.

In the Supreme Court of the District of Columbia, the 5th Day of November, 1900.

THE BRONSON COMPANY	} At Law. No. 43585.
<i>vs.</i>	
CHARLES H. DUELL, Commissioner of Patents.	

The clerk of said court will note an appeal from the order dismissing petition.

WALTER F. ROGERS,  
*Attorney for Bronson Company.*

Citation waived.

W. A. MEGRATH,  
*Attorney for Respondent.*

Nov. 5, 1900.

[Endorsed:] At law. No. 43585. U. S. *ex rel.* Bronson Co. *vs.* Duell. Order for appeal & waiver of citation. Filed Nov. 6, 1900. J. R. Young, clerk.

15 Supreme Court of the District of Columbia, Monday, November 5, 1900.

UNITED STATES <i>ex Rel.</i> THE BRONSON COMPANY <i>et al.</i> , Relators,	} At Law. No. 43585.
<i>v.</i>	
CHARLES H. DUELL; Comm'r of Patents.	

It is ordered that the fifty dollars deposited herein as security for costs be retained by the clerk in lieu of a bond on appeal.

16 Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, } ss:  
*District of Columbia,*

I, John R. Young, clerk of the supreme court of the District of Columbia, hereby certify the foregoing pages, numbered from 1 to 15, inclusive, to be a true and correct transcript of the record, as prescribed by rule 5 of the Court of Appeals of the District of Columbia, in cause No. 43585, at law, wherein The United States of

America on the relation of The Bronson Company *et al.* are plaintiffs and Charles H. Duell, Commissioner of Patents, is defendant, as the same remains upon the files and of record in said court.

In testimony whereof I hereunto subscribe  
Seal Supreme Court my name and affix the seal of said court, at  
of the District of the city of Washington, in said District, this  
Columbia. 9th day of November, A. D. 1900.

JOHN R. YOUNG, *Clerk.*

Endorsed on cover: District of Columbia supreme court. No. 1031. The U. S. of America on the relation of the Bronson Company *et al.*, appellants, *vs.* Charles H. Duell, Commissioner of Patents. Court of Appeals, District of Columbia. Filed Nov. 13, 1900. Robert Willett, clerk.



DEC 5 - 1900

**In the Court of Appeals**  
CLERK.

OF THE DISTRICT OF COLUMBIA.

OCTOBER TERM, 1900.

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No. 1031.

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No. 11, SPECIAL CALENDAR.

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THE UNITED STATES OF AMERICA, ON THE RELATION OF THE BRONSON COMPANY, ADELBERT E. BRONSON, JR., VICTORIA BRONSON, AND THOMAS C. WILLARD, Appellants,

*vs.*

CHARLES H. DUELL, Commissioner of Patents.

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BRIEF FOR THE COMMISSIONER OF PATENTS.

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W. A. MEGRATH,

*Counsel.*

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WASHINGTON:

GOVERNMENT PRINTING OFFICE.  
1900.



# In the Court of Appeals

OF THE DISTRICT OF COLUMBIA.

OCTOBER TERM, 1900.

THE UNITED STATES OF AMERICA  
on the Relation of the Bronson  
Company, Adelbert E. Bronson,  
Jr., Victoria Bronson, and  
Thomas C. Willard,

*Appellants,*

v.

CHARLES H. DUELL,  
*Commissioner of Patents.*

No. 1031.

No. 11, Special Calendar.

*May it please the Court :*

On November 5, 1900, Mr. Justice Cole entered an order denying petitions for writs of mandamus in three trade-mark cases which involved the question of the jurisdiction of the Commissioner of Patents to consider and decide whether an alleged trade-mark which was offered for registration in the Patent Office was a lawful trade-mark. In

two of these cases the right of an applicant to register under section 13 of the trade-mark act was involved. The judge denied the petition in all the cases on the ground that the question of the jurisdiction of the Commissioner was settled by this court in the South Carolina case (2 D. C. App., 240; 66 O. G., 1167; C. D., 1894, 174), holding that in view of that decision the question was not open for his interpretation. The decisions of the court below were not filed, although copies were furnished to counsel in those cases. The judge's opinion in the case under consideration is printed as Appendix A to this brief.

The relators in the two cases involving the right under section 13 of the act did not appeal. The relators in the other case have filed this appeal. Both the relators and the respondent in this case filed in the court below printed briefs discussing substantially all the questions raised by this appeal. The brief filed below for the respondent has been put under cover with the additional remarks that are here made in answer to certain new statements made by appellants in their brief filed in this court, and your Honors are referred to that brief for appellee's position. For convenience in considering that brief it may be stated that appellants' first nineteen "Points," except the sixth, as appear on pages 6 to 15 of their brief before this court, are the same as those in their brief below. In others words, Points I to V are Points I to V in their brief below, and Points VII to XX are Points VI to XIX below. Most of the argument of appellants on pages 20 to 46 of their brief also appears in their brief below. The only new matter that need be referred to here is that appearing at the bottom of page 21 and top of page 22, relating to the decision of this

court in the case of *Einstein v. Sawhill*, (2 D. C. App., 10; 65 O. G., 1918; C. D., 1893, 677); that on page 26 under title "The Act of 1881," and that on page 30 relating to the case of *Grant v. Raymond*, (6 Peters, 218). It may be noted that some of the points or questions so elaborately discussed below by appellants, notably the comparison of the old law with the new, have disappeared from the brief now filed by them.

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At the outset appellee desires to correct a statement on page 2 of appellants' brief. On that page appears the following:

"Being thus apparent, and it being in fact in accordance with the oral statement of the Commissioner, that he desired a review by the courts of his power as register of trade-marks, a petition for mandamus was filed by the counsel for the Bronson Company in the Supreme Court of the District of Columbia."

In the first place, it is believed that appellants should confine their arguments to the record and not refer to alleged oral statements of the Commissioner. They are in error when they state that the Commissioner "desired a review by the courts of his power as register of trade-marks" in this case. What he did say was that if the Bronson Company or its counsel desired to have the court review his decision he had no objection to a petition for writ of mandamus being filed by them. This quoted statement might lead one to believe that the Commissioner of Patents was in doubt as to his power to pass upon and decide the question before him. He has no doubt of his

power under the trade-mark law and never has had any doubt.

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On pages 3, 21, and 22 appellants refer to this court's decision in the case of *Einstein v. Sawhill*, *supra*, as showing that the court had decided that the Commissioner's power in registering a trade-mark is restricted and that his powers and duties in such matters are scarcely more than ministerial. It is true that your Honors in that case used this language in referring to the present trade-mark law:

"All that Congress has sought to do is to provide a recording act of a very limited character the better to evidence the ownership of the right, \* \* \* and the scarcely more than ministerial business of the registration of trade-marks."

But your Honors will remember that the question of the authority and duty of the Commissioner of Patents in the matter of the registration of trade-marks and the right of the Commissioner to pass upon the question whether the mark offered for registration was a lawful trade-mark were not before the court in that case. That case involved the question and only the question whether the act creating the Court of Appeals of the District of Columbia permitted appeals to it from the decision of the Commissioner of Patents in trade-mark cases.

To quote from the court:

"The question before us for determination is whether the right of appeal so given included cases of dispute between rival applicants for registration of trade-marks."

That was the only question before your Honors and was the only one decided by you in that case. The language quoted from that decision by the appellants, it is submitted, is merely *dictum*. Reading further from the decision, it would appear that language is found in it from which it could be inferred that the Commissioner had the power to decide whether an alleged trade-mark offered for registration was a lawful trade-mark and to refuse registration when he considered it to be not a lawful trade-mark. The language is:

“We are therefore justified in concluding that when Congress provided in the act of 1893 for appeals in interference cases, it was their intention to provide for such cases as had always been known and designated as ‘interference cases,’ and no others. Indeed, it would be a most unaccountable anomaly if we should hold differently, for, *if the construction contended for by the appellant should prevail, we would have the very peculiar arrangement that appeals would not be allowed from decisions of the Commissioner refusing to register trade-marks and yet would lie in disputed or controverted cases, and the result might well be that after we had decided in favor of one of the contestants the Commissioner might even then refuse to register the trade-mark for the applicant whom we would regard as entitled, and from his refusal there would be no appeal.*”

But whether or not the language quoted by the appellants is *dictum*, the question of the right of the Commissioner to pass upon the lawfulness of claims to an alleged trade-mark offered for registration was settled by your Honors later in the South Carolina case, in which this question was involved. That decision is fully discussed in the brief filed below on behalf of respondent. In that case your Honors said:

"We think it plain that the duties of the Commissioner are something more than ministerial, and that they differ widely from the duties of a mere register of deeds or receiver of papers for file, with which an attempt has been to institute a comparison."

Again your Honors said :

"Grant that his decision on this and other points was erroneous; still, the construction of these laws was a matter submitted to his discretion, and for the exercise thereof he is not responsible to the judicial power.

\* \* \*

"We are clearly of the opinion that the duties imposed upon the Commissioner of Patents by the trade-mark act are not ministerial, but that their proper discharge requires the exercise of judgment and discretion, and that therefore his action can not be controlled in this proceeding."

That case would seem to entirely dispose of this question, but in view of its importance the whole question was discussed in the brief below, and this additional brief is filed on the subject.

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On page 30 of appellant's brief, reference is made to the case of *Grant v. Raymond, supra*. That was a patent case, and it is gathered from what appellants say in their brief that they attempt to argue by analogy that as the Supreme Court held in that case "that the Secretary of State may be considered in issuing a patent as a ministerial officer," and as he could not "decide those judicial questions on which the validity of the first patent depends," the Commissioner of Patents, under the trade-mark act, is a ministerial officer,

and can not decide the judicial question whether or not the mark offered for registration is a lawful trade-mark. An examination of that case, however, will show that the contention of the appellants can not be sustained on this theory. That case came under the patent act of 1793, which provided—

“That when any person or persons \* \* \* shall *allege* that he or they have invented any new or useful art \* \* \* and shall present a petition to the Secretary of State signifying a desire of obtaining an exclusive property \* \* \* it shall and may be lawful for the said Secretary of State to cause letters patent to be made in the name of the United States \* \* \*.”

That case might be in point for appellants if the present trade-mark law provided that when any one *shall allege* that he is the owner of a trade-mark, etc., it shall be lawful for the Commissioner to register the mark. Under such a supposed law, if the Commissioner refused to register a mark, a mandamus might lie to compel him to do so, but such is not the case. Appellants in this same connection argue:

“Now, let us suppose that the Congress, after full debate, should yield to the pressure brought to bear upon it repeatedly, to return to the registration system, and should, to that end, strike out section 31 (R. S., Sec. 4893), empowering the Commissioner to make an examination, and should, in the same line, remove the several statutory bars from Revised Statutes, section 4886, and change it to read simply ‘That any person who has invented or discovered any new and useful art may, upon payment of the duty required by law, obtain a patent therefor,’ would the Commissioner proceed to examine the application precisely as before, on the

ground that the law, as thus stated, required him to decide whether or not the invention is new and useful?"

What the Commissioner would or would not do under such a law is not pertinent here. The present trade-mark law is not such a radical departure from the old law as contended for by appellants. It is true that the new law has not provided for the registration of proposed trade-marks, but is confined to trade-marks actually used in commerce with Indian tribes or foreign nations, yet the power of the Commissioner to pass upon the question whether an alleged trade-mark offered for registration is a lawful trade-mark and upon the right of an applicant to have it registered was not taken away from him by the new law. The similarity of the two laws is fully discussed in respondent's brief below.

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On page 26 of appellant's brief is quoted matter from what they term "the only recent treatise of any weight" (Greeley's Foreign Patent and Trade-Mark Laws), as showing the character of the present trade-mark law. Can appellants point to any statement in that treatise that the Commissioner is not clothed with authority to pass upon and decide whether an alleged trade-mark, offered for registration, is or is not a lawful trade-mark and to pass upon the lawfulness of claim to the alleged mark? The author of that treatise was recently the Assistant Commissioner of Patents. Can appellants point to any decision by him, as Assistant or Acting Commissioner, in which there is any intimation that he believed that the Commissioner of Patents was not clothed with this power? This author, while Assistant

Commissioner, compiled that treatise, and was at that time and is now one of the commissioners to revise the trade-mark laws, and the whole subject was before him, yet in every case that came before him on appeal from the decision of the examiner of trade-marks, refusing to register a trade-mark, he passed upon the lawfulness of the alleged trade-mark, and when he considered that the mark offered for registration was a lawful trade-mark he decided that it should be registered. See *ex parte* Hampden Watch Co., 81 O. G., 1282; C. D., 1897. 792, where the question whether "Menlo Park" was a geographical term was under consideration; *ex parte* Durkee & Co., 82 MS. Dec., 14, where registration of the word "Imperceptible" was allowed for starch, and *ex parte* Cream of Wheat Co., 62 MS. Dec., 333, where the words "Cream of Wheat" were registered for a cereal.

When he considered the mark offered for registration not to be a lawful trade-mark he refused to register it. See *ex parte* Martin, 89 O. G., 2259; C. D., 1899, 250, where he refused to register the picture of a paper bag; *ex parte* Gill Paper Co., 62 MS. Dec., 243, where it was held that "Old Yorkshire Mills" for paper was geographical; *ex parte* Flouring Mill Co., 62 MS. Dec., 437, where the words "Seal of Minnesota" for flour were refused registration; *ex parte* Cummings, 63 MS. Dec., 45, where "White Laurel" was refused for medicine, as being descriptive; *ex parte* Dunbar, 63 MS. Dec., 65, where the words "Old Fashion" were refused registration for molasses, on the ground that they were descriptive; and *ex parte* McWilliams, July 27, 1898, where the words "None Such" were refused registration for horse blankets, on the ground that they were descriptive.

Every Commissioner of Patents and Assistant Commissioner from the time of the passage of the present trade-mark law to date has construed the law as giving him authority to pass upon this question. See pages 39 to 48 of respondent's brief below. The first case was decided May 28, 1881, less than three months after the passage of the act. Appellant's statement on page 26 of his brief:

"And it needs but a reading of the trade-mark decisions of the Commissioner of Patents to show how, little by little, the bureau has encroached upon the functions of both the Congress and the courts,"

is therefore without foundation. The Commissioners have not gradually encroached upon the functions of Congress and the courts. They have decided from the outset that they had authority to pass upon the judicial question whether an alleged trade-mark offered for registration was a lawful trade-mark and to decide the lawfulness of the alleged trade-mark.

In connection with this question of the interpretation of the trade-mark act by the bureau officers who had to act under it, your Honor's attention is called, in addition to what is said on page 48 of respondent's brief below, to the decision of the Supreme Court of the United States in the case of *Bate Refrigerating Co. v. Sulzberger*, 157 U. S., 1; 70 O. G., 1633; C. D., 1895, 233. That case involved the interpretation of the patent act of 1870, but it is believed that the holding of the court in that case is pertinent here. In that case a section of the patent act of 1870 was under consideration. Mr. Justice Harlan, speaking for the court, quoted a number of decisions from Commissioner Fisher

upon the interpretation of that section, prefacing the quotations by this language:

"What was the interpretation placed upon the act of 1870 by the executive branch of the Government?"

"The objects and scope of that act were considered by Mr. Fisher, the Commissioner of Patents, in several cases within a few months after the passage of the act of 1870. The decisions of the Commissioner derive some importance from the fact that they were rendered while the changes made by the act of 1870 were fresh in the minds of those who, like himself, took special interest in legislation affecting patent rights."

After quoting from the decisions of Commissioner Fisher, Mr. Justice Harlan then said:

"We have not been referred to any ruling of the Patent Office, after the passage of the act of 1870, in conflict with or different from that of Commissioner Fisher, except one made by Commissioner Paine in 1880. But in reference to the latter ruling and the construction of the act of 1870 under which the Commissioner of Patents had uniformly proceeded, Commissioner Marble, in a letter to the Secretary of the Interior, under date of March 7, 1882, said:

"As will be seen by Col. Mason's communication, the construction now put upon the statute is the construction which it has received since it was enacted, except during a short interval of the term of my predecessor, Mr. Commissioner Paine. I may state, however, that Mr. Commissioner Paine addressed to me a letter within one month after he had retired from office, stating that he believed his construction of section 4887 was erroneous.' "

Later on he said:

“\* \* \* if the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting one of two constructions; this Court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the Government.”

Mr. Marble was the Commissioner of Patents when the bill which became the present trade-mark law was under consideration by the committees of Congress, and he was the first Commissioner who was called upon to construe that law. As has been before stated, he had occasion to construe it in less than three months after its passage. Appellants admit below that the officials of the Patent Office aided in the preparation of that bill, and it is fair to presume that these officials knew what changes were made in the law and what was intended to be covered by the new law. Commissioner Marble, after comparing the trade-mark law of 1870 with the new law, said:

“\* \* \* the present law makes no provision for the registration of prospective trade-marks, if they may be so called, or of trade-marks not in use in foreign commerce; but in other respects, as I read it, the law is unchanged. I find in the passage quoted two prerequisites named as essential to a valid registration: first, that it shall appear that the proposed trade-mark is lawfully used as such, and, second, that it shall appear that it is used in foreign commerce or in commerce with Indian tribes. It is clear that the oath of the applicant can not establish the existence of the first of these conditions, where it appears upon inspection that a proposed trade-mark consists of words in

general use, to which the applicant can have no exclusive right, or that the proposed trade-mark is not, in fact, a trade-mark in contemplation of law."

*Ex parte* Strasburger & Co., 20 O. G., 155; C. D., 1881, 23.

See also *ex parte* Kipling, 24 O. G., 889; C. D., 1883, 54, and other cases that might be cited.

To paraphrase the language of Mr. Justice Harlan and substitute the name of Commissioner Marble for that of Commissioner Fisher: The objects and scope of the act of 1881 were considered by Mr. Marble, the Commissioner of Patents, in several cases within a few months after the passage of that act. The decisions of the Commissioner derive some importance from the fact that they were rendered while the changes made by the act of 1881 were fresh in the minds of those who, like himself, took special interest in legislation affecting the registration of trade-marks, and your Honors have not been referred to any ruling of the Patent Office, after the passage of the act of 1881 in conflict with or different from that of Commissioner Marble.

If there be reasonable ground for adopting one of two constructions of the act of 1881 your Honors may well adopt that construction which is in harmony with the settled practice of the Patent Office.

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Appellants say on page 40 of their brief:

"No injury can flow from the issuance of this writ. It is of the first importance that it should be known definitely that our law is a registration law and not an attributive law."

It is submitted that writs of mandamus are not issued

against executive officers of the Government merely because no injury can flow from their issuance. They are issued only in clear cases and when there is any doubt as to the power and duties of the executive officer, that doubt is waived in favor of the long-continued practice of an executive office. It is submitted that the scope of the trademark act is settled by the long-continued practice and by this court's decision in the South Carolina case.

If, as appellants state on page 39 of their brief, "it is the consensus of opinion at the bar that the interest of the public is best served by a registration law," the parties interested should apply to Congress to have the present trademark law changed and not come to the courts to have them legislate and modify the long-established interpretation of the law. It would seem that now is a suitable time to make such application to Congress. The President has under authority of Congress appointed a commission consisting of three members to report on the revision of the trademark law. One of these members is the counsel who appeared in one of the trademark cases referred to above and not appealed to this court, and another is the author of the treatise referred to by appellants on page 26 of their brief. If it be advisable to have simply a registration law, no doubt upon proper representation to this commission they will recommend that the law be changed accordingly.

It is submitted that the decision of the court below in refusing to grant the petition for writ of mandamus was correct and should be sustained.

W. A. MEGRATH,

*Counsel for Appellee.*

December 3, 1900.

## ANSWER TO "SUPPLEMENTAL BRIEF FOR APPELLANTS."

Since the foregoing brief was prepared one of the parties who signed the so-called "Supplemental Brief for Appellants," printed as Appendix B to this brief, asked permission from this court to file a brief as *amicus curiae*. Permission was granted and counsel for appellee was then furnished with a type-written copy of a paper entitled "Supplemental Brief for Appellants," with fourteen signatures.

The matter contained in the first paragraph of this paper needs no answer, for the question whether the Commissioner has judicial power to decide or discuss the validity of a trademark offered for registration is the question before this court for consideration, and your Honors will decide it on the law governing the case, regardless of the opinion of those who signed that paper.

In the next paragraph appears this statement:

"The present attitude of the Patent Office stands in the way of an amendment of the law extending its provisions to interstate commerce."

It is presumed that the gentlemen who appended their names to this paper knew what it contained. This being so, there is only one of two explanations of the above-quoted statement possible, either that the statement was made through gross carelessness and ignorance of the attitude of the office or else through malice. These gentlemen are in

active practice before the office and they are subscribers to the Official Gazette. It is therefore fair to presume that they read the Gazette and are interested in the policy of the office and in the recommendations made by the Commissioner of Patents to Congress. On pages 1169 to 1178 of volume 86 of the Official Gazette of the Patent Office appears the Annual Report of the Commissioner of Patents to Congress for the year ending December 31, 1898. Beginning at the bottom of page 1177, under section 5 of the title "Desired Legislation," is found this recommendation of the Commissioner of Patents on the subject of the registration of trademarks used in interstate commerce:

"5. A statute to provide for the registration of trademarks used in interstate commerce.

"I am informed that the commission appointed by the President on July 7 last, under the act approved June 4, 1898, 'to revise the statutes relating to patents, trade and other marks, and trade and commercial names,' which consists of Judge Peter S. Grosscup, Hon. A. P. Greeley, and Mr. Francis Forbes, will in connection with their report to your honorable bodies submit a proposed trade-mark law which will provide for the registration of trademarks used in interstate commerce. I cannot commend that feature too strongly and trust that the act when introduced will receive immediate and favorable action."

On pages 1743 to 1752 of Vol. 90 of the Official Gazette, appears the Annual Report of the Commissioner of Patents to Congress for the year ending December 31, 1899. In this report the Commissioner again recommended that the statutes be amended to provide for the registration of trademarks used in interstate commerce. Beginning at the bottom of page 1751 appears the following:

"The Trade-Mark Statutes should be amended so as to provide for the registration of trade-marks used in interstate commerce. Other amendments are required; but as this subject is being dealt with by the commission appointed in 1898 I refrain from making any further suggestions upon this point."

These recommendations from the Commissioner's Annual Reports show the attitude of the office in regard to extending the law to provide for the registration of trade-marks used in interstate commerce, and show how unwarranted is the statement contained in the so-called "Supplemental Brief for Appellants."

W. A. MEGRATH,  
*Counsel for Appellee.*



## APPENDIX A.

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OPINION OF MR. JUSTICE COLE.

(NOT FILED.)

THE UNITED STATES	}	At Law, 43,585.
EX REL. THE BRONSON COMPANY,		
<i>v.</i>		
DUELL, COMM'R OF PATENTS.		

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This is a petition for a writ of mandamus against the respondent to require him to register the compound word "Ever-Ready" as a trade-mark for coffee mills.

The defendant demurs to the petition and assigns as ground thereof that it appears by the allegations of the petition that the Commissioner has refused to register the alleged trade-mark, and he insists that the law confers upon him a discretion to be exercised as to whether a trade-mark is entitled to registration, and that such discretion can not be controlled by mandamus.

The petitioners in response to this admit that the Commissioner has discretion in the premises in relation to certain matters, but that he declined registration in this case on the ground alleged by him that this is not a valid common law trade-mark, and they contend that the respondent has

no right or power under the law to inquire into that question, or to refuse registration on that ground. It sufficiently appears by the petition that this is the ground upon which registration was refused in this case, and that it would have been registered had the Commissioner found it to be a valid common law trade-mark.

The question, therefore, presented by the petition and demurrer is whether the Commissioner has jurisdiction to inquire whether a trade-mark offered for registration is a valid trade-mark at common law.

The determination of this question involves the construction of the act of Congress of the third of March, 1881, relating to trade-marks.

But this court is saved the difficulty of attempting to construe this statute in the particular mentioned by the opinion of the Court of Appeals in the case of *Seymour v. South Carolina*, 2 D. C. Appeals, 240.

In that case, in the course of a very elaborate and searching opinion, Mr. Justice Shepherd, among other things, said: "The Commissioner is required to decide the presumptive lawfulness of claim to the alleged trade-mark. This, in connection with the preceding portion of the third section aforesaid, can mean nothing less than that in all cases he shall inquire, first, if the applicant has actually used the trade-mark in lawful commerce with foreign nations or with the Indian tribes, and, then, if he has the right to the use of it at all. If he finds that the alleged trade-mark is the name of the applicant, *or any other name*

*which can not be lawfully converted into a trade-mark at common law, \* \* \* he can not admit it to registration.* \* \* \*

The above quotation, especially the part underscored (it is not in italics in the report), shows that the Court of Appeals decided in that case the exact point in controversy in this: But counsel for the relators contend that that part of the opinion is *obiter* and ought not to control the action of this court. It may be true that the South Carolina case might have been decided the same way it was without the expression of any opinion upon the point now in question. But it does not follow that for that reason the portion of the opinion referred to is *obiter*. Nothing is *obiter* if it appears from the report that the point in question was actually considered by the court, and it is very apparent from a reading of the whole opinion in that case that the point was discussed and considered by the court, and that renders the opinion as binding upon this court as if the point in question had been the only one in the case.

The statute mentioned, therefore, is not open to the construction of this court in the particular raised by the pleadings in this case, but it is its duty to follow the construction which it has already received by the Court of Appeals.

According to that construction it was the duty of the Commissioner of Patents to pass upon the question he has decided, and, that being so, mandamus does not lie to control his action, and the petition must be dismissed.

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## APPENDIX B.

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### IN THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

THE UNITED STATES OF AMERICA, *ex rel.*  
THE BRONSON COMPANY *et al.*  
v.  
THE COMMISSIONER OF PATENTS.

} Appeal from Su-  
preme Court of  
the District  
of Columbia.  
Special Calen-  
dar, No. 11.

### SUPPLEMENTAL BRIEF FOR APPELLANTS.

The undersigned, the Court consenting, desire to join with the counsel for appellants as *amici curiae*.

In our opinion the trade-mark act of 1881 is a registration law opposed to the attributive act of 1870. The act of 1881 is a recording act of limited character, giving to the Commissioner of Patents a scarcely more than ministerial business as register of trade-marks; and the Commissioner has no judicial power to decide or discuss the validity of a mark. As in the South Carolina case, 2 D. C. App., 240, he may on occasion decide the presumptive lawfulness of claim to a word, as "Palmetto," but not the lawfulness or validity of that word if actually used by one who presumptively may be the owner.

The present attitude of the Patent Office stands in the way of an amendment of the law extending its provisions to

interstate commerce. No injury, but on the contrary, a benefit to the public would flow from the administration of the law as a registration law and the recording of such marks as that of the appellants, subject only to the specific exceptions of Section 3, and the clerical regulations.

Respectfully submitted,

W. C. DODGE,

S. T. FISHER,

MAX GEORGII,

ROBERT T. FISHER,

WILLIAM W. DODGE,

WM. C. MCINTIRE,

GEO. P. WHITTLESEY,

W. D. BALDWIN,

ELLIS SPEAR,

A. P. GREELEY,

WM. H. DOOLITTLE,

L. S. BACON,

G. H. WHITAKER,

W. A. BARTLETT.



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In the Supreme Court of the District of Columbia.

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THE UNITED STATES OF AMERICA  
on the relation of The Bronson  
Company, Adelbert E. Bronson, jr.,  
Victoria Bronson, and Thomas C.  
Willard, relators,

At law,  
No. 43,585.

CHARLES H. DUELL, COMMISSIONER  
of Patents of the United States,  
respondent.

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BRIEF FOR THE RESPONDENT.

W. A. MCCRATH,

Counsel.

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[illegible]

In the Supreme Court of the District of Columbia.

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THE UNITED STATES OF AMERICA  
on the relation of The Bronson  
Company, Adelbert E. Bronson, jr.,  
Victoria Bronson, and Thomas C.  
Willard, relators,  
v.  
CHARLES H. DUELL, COMMISSIONER  
of Patents of the United States,  
respondent.

At law,  
No. 43,585.

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**BRIEF FOR THE RESPONDENT.**

May it please the court :

**STATEMENT OF THE CASE.**

On the 3d day of January, 1900, the relators filed in the supreme court of the District of Columbia a petition for a writ of mandamus, commanding the respondent to register for the relators the word "Ever-Ready" as a trade-mark for coffee mills.

The petition of the relators alleges that on the 7th day of December, 1898, they filed in the United States Patent Office an application for the registration of the compound word "Ever-Ready" as a trade-mark for coffee

mills; that subsequently to said date the examiner of trade-marks refused to register the said word as a trade-mark, on the ground that it is descriptive; that subsequently thereto, on the 6th day of May, 1899, they appealed from the action of the said examiner to the Commissioner of Patents, and that on May 18, 1899, the Commissioner of Patents refused to register the said mark, on the ground that it is not a trade-mark.

The relators charge in their petition :

That the said Commissioner of Patents had no right or authority to refuse registration of their lawful trade-mark; that there is no power in the said respondent, the Commissioner of Patents, under the statutes of the United States providing for the registration of trade-marks, to refuse to register a trade-mark for any reason not specifically and precisely defined in the above-mentioned statutes, and that the said Commissioner of Patents had no authority under the said statutes to refuse registration, upon the ground that the said mark is descriptive or upon the ground that the said mark is not a trade-mark, as defined by the said Commissioner of Patents in his said decision of May 18, 1899, and that in respect to these matters the function of the Commissioner of Patents is ministerial and not judicial, and that by the said rejections of the said trade-mark the Commissioner of Patents has exceeded the authority reposed in him by the said statutes.

The relators pray this honorable court to issue a writ of mandamus commanding the respondent to set aside the rejection of said mark and to register it. The Commissioner demurred to the petition on the ground that the court has no jurisdiction over the question of the registration of trade-marks.

If the facts are as alleged in the relators' petition, it is submitted that this honorable court has no jurisdiction over the question of the registration of trade-marks, as the trade-mark law, under which the relators seek registration, makes the Commissioner of Patents the sole and final judge as to the right of an applicant to have an alleged mark registered as a trade-mark; it makes the Commissioner of Patents, in an application for the registration of trade-marks, the sole and final judge as to the presumptive lawfulness of claim to the alleged trade-mark.

#### THE LAW OF MANDAMUS.

The law of mandamus, as applied to executive officers of the Federal Government, is well settled. A writ of mandamus can not be used to perform the office of an appeal or writ of error, to review the judicial action of an independent tribunal. (*Commissioner of Patents v. Whiteley*, 4 Wall., 522; *Decatur v. Paulding*, 14 Peters, 497.) The writ can lawfully be used to put the officer in motion where he has failed or refused to act. The two leading cases in the Supreme Court of the United States in which this question has been considered are *Kendall v. Stokes*, 12 Peters, 524, and *Decatur v. Paulding*, *supra*.

In the first of these cases the court ordered that the writ be issued, while in the other the writ was refused. The subsequent cases have done little more than follow the rule laid down in those two.

Mr. Justice Bradley, in speaking for the Supreme Court in the case of the *United States ex rel. Dunlap v.*

*Black* (128 U. S., 40, 48), referring to those two cases said :

The principle of law deducible from these two cases is not difficult to enounce. The court will not interfere by mandamus with the executive officers of the Government in the exercise of their ordinary official duties, even where those duties require an interpretation of the law, the court having no appellate power for that purpose; but when they refuse to act in a case at all, or when, by special statute or otherwise, a mere ministerial duty is imposed upon them, that is, a service which they are bound to perform without further question, then, if they refuse, a mandamus may be issued to compel them.

The Supreme Court, in the case of *Mississippi v. Johnson* (4 Wall., 475, 498), defined a ministerial duty as follows :

A ministerial duty, the performance of which may, in proper cases, be required of the head of a department by judicial process, is one in respect to which nothing is left to discretion. It is a simple, definite duty, arising under conditions admitted or proved to exist, and imposed by law.

To determine whether the duty of the Commissioner of Patents in this case, under the trade-mark act, is ministerial and not judicial, as charged by the relators, whether it is a duty "in respect to which nothing is left to discretion," whether it is "a simple, definite duty, arising under conditions admitted or proved to exist, and imposed by law," it is necessary to examine the trade-mark law under which the relators claim the right to have their alleged trade-mark registered.

## THE TRADE-MARK ACT.

At the outset it may be stated of the trade-mark act that no appeal lies from the decision of the Commissioner of Patents in refusing to register an alleged trade-mark. His decision is final.

Section 1 of the trade-mark act, "An act to authorize the registration of trade-marks and protect the same," approved March 3, 1881, provides that "owners of trade-marks used in commerce with foreign nations or with the Indian tribes \* \* \* may obtain registration of such trade-marks \* \* \*

First. By causing to be recorded in the Patent Office a statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, with facsimiles thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used.

Second. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents.

Section 2 requires—

That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time

a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or Indian tribes, as above indicated; and that the description and facsimiles presented for registry truly represent the trade-mark sought to be registered.

Section 3 provides—

That the time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

There are other sections of this act which will be referred to hereinafter, but it is not necessary to consider them now.

The relators' contention is that judicial power is conferred upon the Commissioner of Patents under the trade-mark act in an *ex parte* case to consider only four questions, all of which they allege may appear from the papers of the applicant or the records of the Patent Office. These four questions they state as follows:

- (1) Lawful use in foreign or tribal commerce;
- (2) If it be the subject of a treaty, convention, or declaration;
- (3) If it be merely the name of an applicant;
- (4) If it be identical or substantially identical with a known or registered trade-mark of the same class owned by another.

They contend that when the Commissioner has determined these questions his duty and authority end, and that he can not refuse to register a mark and issue a certificate when he decides these questions in applicant's favor; that outside of the determination of these four specific matters the acts of the Commissioner of Patents are ministerial only and subject to the mandate of the court.

Nowhere in the trade-mark act is a trade-mark defined, but must the Commissioner not decide whether the thing offered for registry is as a matter of law a trade-mark, and whether the party offering the same for registration is the owner thereof? Section 1 of the trade-mark law says that "owners of trade-marks," etc., "may obtain registration," etc., not *alleged* owners of *alleged* trade-marks. The words "owners of trade-marks" limit the right of registration to an applicant who possesses the legal title to that for which registration is sought, and

they further limit the right of registration to that which is a trade-mark—a lawful trade-mark.

An application for registration, correct in all matters of form, is presented to the Commissioner of Patents. He examines the application and decides that the alleged mark is not a trade-mark, because it is a geographical name; *Canal Company v. Clark* (13 Wall., 311); *Columbia Mills Company v. Alcorn* (65 O. G., 1916, C. D., 1893, 672); or a descriptive word or term; *Coats v. Merrick Company* (45 O. G., 347, C. D., 1888, 498); *Rumford Works v. Muth* (35 Fed. Rep., 524); *Indurated Fiber Company v. Amoskeag Company* (37 Fed. Rep., 695); *Jaros Company v. Fleece Company* (65 Fed. Rep., 424); *Bennett v. McKinley* (65 Fed. Rep., 505); *Proctor & Gamble v. Globe Company* (92 Fed. Rep., 357); or a label; *Ex parte Moodie* (28 O. G., 1271, C. D., 1884, 35); *United States ex rel. Moodie v. Butterworth, Commissioner of Patents* (30 O. G., 97, C. D., 1885, 1); or that the trade-mark would be a fraud upon another merchant; *McLean v. Fleming* (96 U. S., 425). Must the Commissioner ignore these facts and register the thing presented as a trade-mark because the application for registration is unobjectionable in form, when in law and equity it is not a valid trade-mark? Would not such a proceeding be manifestly obnoxious to, if not positively against the reason, spirit, and words of, the trade-mark act?

The duty of the Commissioner to examine into and decide whether an alleged trade-mark is in fact a trade-mark and whether it should be registered is not left, however, to any inference that may be drawn from the

words "owners of trade-marks" in section 1 of the statute.

The second paragraph of section 1 of the trade-mark act authorizes the Commissioner to prescribe regulations governing the registration of trade-marks. Section 20 of these regulations, following the decisions of the courts as to what are not valid trade-marks, states that no trade-mark will be registered "which is simply descriptive in its nature." This regulation, not being inconsistent with the statute, has all the force and effect of the statute and gives the Commissioner the authority to inquire into the question whether the thing offered for registration as a trade-mark is descriptive of the quality of the goods to which it has been applied. In the case under consideration the Commissioner has subjected the word "Ever-Ready" to the tests laid down by the authorities, and has held that said word is descriptive and has refused to register it.

But it is not necessary for the respondent to rely upon a regulation promulgated by the Commissioner for his authority to pass upon the question as to whether the mark offered for registration is a valid and lawful trade-mark. Section 3 of the trade-mark act specifically states that "in an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the *alleged* trade-mark." The relators admit that this section of the statute gives the Commissioner of Patents authority to decide the presumptive lawfulness of claim to an alleged trade-mark when there is an adverse party, but they contend that he does not have this authority in an *ex parte* case. Why make this admission when there

is an opposing claimant but refuse it when there is no opposing party? Is the duty of the Commissioner any the less extended or any different in kind in *ex parte* cases than in disputed cases? Are his powers discretionary, *quasi* judicial, or judicial in disputed cases, but merely ministerial in *ex parte* cases, when the question as to whether the thing presented is a lawful trade-mark and the ownership of the mark arises? The language of the trade-mark act makes no such distinction in the duty of the Commissioner between *ex parte* and disputed cases as contended for by the relators. It says the Commissioner of Patents "shall decide the presumptive lawfulness of claim to the alleged trade-mark." These words are equally applicable to and intended to apply to both *ex parte* and disputed cases. There is no separation of the two kinds of cases in the words of the act. In one class one applicant seeks registration, while in the other several applicants seek registration. The words "and in any dispute between an applicant and a previous registrant or between applicants he shall follow, so far as the same may be applicable, the practice of the courts of equity of the United States in analogous cases" are separated from the preceding phrase by a semicolon, and they are words merely directory as to the manner of conducting the proceedings when there is a contest and are not words of limitation confining the inquiry of ownership to disputed cases. Not a word is to be found in this section of the statute which limits the inquiry to disputed cases. Such an interpretation of the law and the duties of the Commissioner thereunder as contended for by the relators is too

narrow. An applicant complying with the requirements of sections 1 and 2 of the trade-mark act as to the form of his application presents to the Commissioner a *prima facie* case of lawfulness of claim to registration. He makes out a case of "presumptive lawfulness of claim" to the alleged trade-mark. It is this presumption that section 3 of the act requires the Commissioner of Patents to decide. In his decision on the presumptive lawfulness he may and it is his duty as a matter of law and equity to decide the real case; that is to say, to decide the case so that his decision may meet with the approval of a court in a proper case.

The Commissioner of Patents is not to issue a certificate of registration certifying that the applicant has complied with the trade-mark law and that the protection for the trade-mark will remain in force for thirty years, when he knows, morally, equitably, or legally, that the subject-matter thereof is void.

Suppose, after the decision of the courts in any of the cases above cited, holding that the word or term passed upon was not a trade-mark, and that the alleged owner had no right to the exclusive use of such a word or term, that a party should have applied for the registration of the same mark, would it be held that the Commissioner of Patents could not lawfully refuse the certificate of registration? If it be held that the Commissioner can properly ignore these decisions, on what ground can he do so? That he is a mere ministerial officer in the matter of registering trade-marks? That the United States, in whose name the certificate is issued, is not concerned with the truth or falsity of the "lawfulness of claim"

to the alleged trade-mark? The trade-mark statute does not create trade-marks, but as a matter of law and fact the holder of the certificate of registration has conferred upon him by such certificate advantages if not rights which are created by said statute. Section 7 of this act says that registration of a trade-mark shall be *prima facie* evidence of ownership. Section 9 gives the registrant a new right that the common law does not give him. The statute also gives the registrant the right to sue a citizen of his own State in a Federal court.

The specific advantages of the Federal registration are (1) that it creates testimony, as registration is *prima facie* evidence of ownership in the trade-mark. Not only the certified statement or specification, and the declaration, fix the title in the registrant as against any other claimant, thereby throwing the burden of proof on an adverse claimant, if such there be, but the certificate is evidence in any suit or action in which it is brought in controversy, and establishes the precise description of the symbol claimed, defines the class of merchandise to which the trade-mark is applied and affixed, fixes the date of adoption and use as to all the facts alleged, and obviates what would otherwise be a necessity, i. e., the production of oral testimony, and that at perhaps great inconvenience and expense. (2) Registration is a means of effecting and effectuating treaty stipulations on this subject. (3) Registration gives cognizance to courts of the United States in controversies between inhabitants of the same State where a trade-mark used in foreign commerce is involved. (4) By registration, original and appellate

jurisdiction is given to those courts without regard to the amount in controversy. (5) It gives a right to damages sustained in consequence of false representations made by a rival registrant. (6) Registration has a strong moral effect in deterring infringements and in suppressing rival traders. (7) The assertion of a Federal title of ownership gives an air of permanence and validity to the trade-mark and is eagerly sought for its moral effect "on the trade." (8) Registration is an indispensable prerequisite to a criminal prosecution for counterfeiting, or selling of goods falsely marked, under the penal statute of August 14, 1876. While it is admitted that the trade-mark act does not *create* a trade-mark, it is evident upon a survey of these advantages conferred upon a registrant and obtained only by virtue of the Federal trade-mark law, and upon an examination of the whole of the trade-mark statute, and especially of the language which prescribes that the applicant shall show that he "has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use," and that the Commissioner "shall decide the presumptive lawfulness of claim to the alleged trade-mark," that the framers of the trade-mark act did not contemplate that the duties of the Commissioner of Patents under the act should be merely to register every alleged trade-mark presented for registry. Are these rights—whether they be small or great—to be created simply by the applicant leaving an application for registration at the Patent Office? It is contrary to the genius of our institutions to confer special privileges until

and unless the party seeking them has substantiated his claim to the privileges before the proper authority. In the case of the registration of trade-marks, the proper authority is the Commissioner of Patents.

#### AUTHORITIES.

The case that seems to be conclusive as to the question of the Commissioner's right to decide the presumptive lawfulness of an applicant to an alleged trade-mark in an *ex parte* case under the trade-mark act is that of the *United States ex rel. the State of South Carolina v. John S. Seymour, Commissioner of Patents* (66 O. G., 1167; C. D. 1894, 174).

The facts in that case may be briefly stated as follows: Benjamin R. Tillman, governor of the State of South Carolina, on behalf of that State, filed an application in the United States Patent Office for the registration of the word "Palmetto" as a trade-mark for intoxicating liquors. The Commissioner of Patents refused registration for reasons fully set out in his decision, which concluded as follows:

It is considered that the State of South Carolina, notwithstanding the acts of its governor and State board of control, has no authorized trade in liquors outside its own limits, is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered, and therefore the application is denied.

The State of South Carolina then petitioned the supreme court of the District of Columbia for a writ of mandamus, to compel the Commissioner to register the

mark presented by the State, and to issue the certificate to said State as the owner of the mark. On demurrer and in answer to the petition, the Commissioner denied that the court had jurisdiction to compel him to register the alleged mark, because his decision upon the questions whether said mark could be lawfully registered or not, and whether the applicant was the owner of the mark, involved discretionary duties upon his part.

Associate Justice Bradley, however, issued the writ, holding—

that the duty of registration of a trade-mark by the Commissioner of Patents is such a one that, in a case where the right is denied to an applicant who has complied with the provisions of the law and the regulations of the Patent Office, its performance can be compelled by mandamus.

From this decision the Commissioner took the case to the court of appeals of the District. There were several errors assigned on behalf of the Commissioner of Patents, but they were all reduced to two, and the argument was directed solely to these two points.

The first of these was that—

the duties of the Commissioner, as prescribed by law, are not ministerial simply, but are such as to call for the exercise of judgment and discretion, and that his decision, having been made in the performance of this discretionary duty, is not subject to revision by the courts.

The second was to the effect that—

the State of South Carolina is not entitled to have this trade-mark registered, because she is not, and can not be, lawfully engaged in foreign commerce.

The questions of the right of the Commissioner to decide in an *ex parte* case the presumptive lawfulness of the claim to an alleged trade-mark, and whether the State of South Carolina was the owner of the trade-mark that was offered for registration, were fully discussed and an elaborate brief on these points was filed on behalf of the Commissioner of Patents, as the record shows, and these questions were there presented so fully that the substance of some parts of that brief has been embodied in this.

The court of appeals took the view contended for on behalf of the Commissioner and overruled the decision of Mr. Justice Bradley, saying:

We are clearly of the opinion that the duties imposed upon the Commissioner of Patents by the trade-mark act are not ministerial, but that their proper discharge requires the exercise of judgment and discretion, and that therefore his action cannot be controlled in this proceeding.

The court of appeals, after reviewing sections 1, 2, and 3 of the trade-mark act, said:

We think it plain that the duties of the Commissioner are something more than ministerial and that they differ widely from the duties of a mere register of deeds or receiver of papers for file, with which an attempt has been made to institute a comparison.  
\* \* \* The Commissioner is required to decide "the presumptive lawfulness of claim to the alleged trade-mark." \* \* \*

If he finds that the "alleged trade-mark" is the name of the applicant *or any other name which can not lawfully be converted into a trade-mark at common law*, or that it is identical with the trade-mark of another, registered or unregistered, or is a deceptive

imitation of another, or that it is not the property of the applicant, he can not admit it to registration, though he may be satisfied that the applicant has used it in regular commerce with foreign nations or the Indian tribes. \* \* \*

No provision is made as to how the Commissioner shall inform himself with respect to the existence of these conditions; but the fact that he is authorized to make regulations and that applicants are required to comply with them would seem necessarily to imply that he is left free to institute the necessary inquiry in his own way.

On the specific point as to whether the Commissioner is authorized by section 3 of the trade-mark act to use his discretion in deciding the presumptive lawfulness of claim to an alleged trade-mark in an *ex parte* case, the court said:

It is contended that, inasmuch as the last clause of section 3 provides for the manner of trial as in courts of equity, so far as applicable, in the event of dispute with a previous registrant or a rival applicant, it necessarily covers and provides for the only contingency in which the Commissioner is authorized to exercise any discretion whatever.

This clause only provides the practice that shall prevail in the event that an actual contest shall be made by rival registrants or applicants, and is in no wise inconsistent with the idea that where there is no contest the Commissioner may make the necessary inquiry into the existence of all the facts necessary to registration in any manner that he may deem adequate to that end. "The presumptive lawfulness of claim," which he is called on to decide, is in express accord with the provision of section 7,

which makes the registration “*prima facie* evidence of ownership.”

This limitation of the effect of the Commissioner’s decision is claimed also as supporting the relator’s contention; but we can see nothing, either in its letter or spirit, which goes to show that the Commissioner’s action in the premises is to be without the exercise of discretion. His determination, either with or without contest, is not made conclusive for the better reason, and one more in accord with the spirit of our institutions, that it would be unwise, and probably unjust, to leave the final determination of what may be a valuable right of property, without respect to the registration, to an executive officer from whose decision there is no appeal.

The contention of the relator in its last analysis is that when a verified application is presented to the Commissioner, and there is no contest depending between the applicant and other parties, there is nothing left to his discretion, and it becomes his imperative duty to issue the certificate of registration.

The reasonable interpretation of the law, in our opinion, is that if there be a contest the Commissioner shall try the same in accordance with the practice of courts of equity, so far as applicable.

But if there be no contest between opposing parties he may accept the sworn declaration as sufficient if he have no cause to suspect its untruth, or he may, in the exercise of his discretion, inquire into the truth of its allegations; and in the event that he should have reasonable ground to suspect that an imposition has been attempted, it would seem to be nothing more nor less than his duty to make an investigation.

The weakness of relator’s contention is further illustrated by the preceding clause of the same section, which expressly prohibits the registration of a

trade-mark which is not lawfully used in foreign commerce, or which is identical with a registered or known trade-mark of another, or which so closely resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

If Congress had intended to make the duty of the Commissioner, where the application is uncontested, ministerial only, it would seem that instead of requiring him to deny registration if certain facts appeared, it would have commanded him to issue the certificate without question upon the presentation of the verified application.

The court of appeals did not stop at deciding that the supreme court was in error in reviewing and revising the decision of the Commissioner of Patents, because the duties imposed upon the Commissioner by the trade-mark act are not ministerial, but their proper discharge requires the exercise of judgment and discretion, but it passed upon the second question raised by the appeal, stating its reason for doing so as follows:

In view of the suggestion by counsel that applications for other trade-marks on behalf of the relator are waiting presentation upon the decision of this case, and because from what has been said, we may have created the impression that we deem the decision of the Commissioner, to the effect that the State could not engage in foreign commerce, erroneous, and as the question has been fully argued, we will express ourselves briefly on the second proposition, though its decision is not absolutely necessary.

Because in passing upon the "second proposition" the court of appeals held that "the Commissioner did not err in the conclusion that the trade-mark applied for had

not been lawfully used in foreign commerce," it is contended by the relators that the court's decision "was directed to the single question of whether or not the State of South Carolina could be lawfully engaged in foreign commerce," and that the rest of the decision, passing upon the right of the Commissioner to decide the presumptive lawfulness of claim to the alleged trade-mark, was mere *dictum*.

It is submitted that this is not a fair interpretation of that decision, when it is remembered that one of the reasons given by the Commissioner for refusing registration was that the State of South Carolina "is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered," when it is remembered that the main question presented to the court was whether the decision of the Commissioner in the registration of a trade-mark is ministerial, or such as to call for the exercise of judgment and discretion, and also when it is remembered that in presenting this question to the court the right of the Commissioner to decide the presumptive lawfulness of claim to the trade-mark, including ownership, one of the specific questions involved in refusing registration was the main argument in the case, the point as to whether the State of South Carolina could engage in foreign commerce being passed upon as a secondary matter, and not then because it was necessary, but because the counsel for the State of South Carolina requested the court to do so, the court stating that the question was decided because there were other trade-marks "waiting presentation upon the decision of this case, and because from what has been said we may have created the

impression that we deem the decision of the Commissioner, to the effect that the State could not engage in foreign commerce, erroneous, and as the question has been fully argued."

The Commissioner refused registration because the State of South Carolina "is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered," and the court held that the Commissioner had a right under the statutes to do this. If the Commissioner in that case had the right to decide whether the State of South Carolina was the owner of a trade-mark and whether it had the right to the use of the mark, it is not seen how it can successfully be contended in the case at bar that the Commissioner exceeded his authority in deciding the presumptive lawfulness of claim to the alleged trade-mark, whether the thing presented for registration by the relators is a trade-mark, and whether they are the owners thereof.

The question whether the thing presented for registration is a trade-mark, and whether the relator has a lawful claim to the alleged trade-mark are so intimately associated that one of these questions can not be separated from the other, for there is no principle more firmly settled in the law of trade-marks than that words or phrases which are used to indicate the character, kind, quality, and composition of the thing may not be appropriated by anyone to his exclusive use, and the exclusive use of such words and phrases the law will not protect.

Words or names which simply indicate the quality of articles or of their ingredients or their character

are, as a general rule, words which others may employ for the same purpose with equal truth, and hence can not be exclusively appropriated by anyone as a trade-mark. They are words of the English language or of other languages used in their ordinary sense, for the purpose for which all men have a right to use them, and to allow any such words to be appropriated by one trader would result in great injustice and inconvenience to the public. (Am. and Eng. Encyc. of Law, vol. 26, p. 289.)

It has been repeatedly held by the courts that a word or phrase descriptive of quality is not a trade-mark, and no one can lawfully claim the ownership of such a word. In the first trade-mark case before the Supreme Court of the United States, *Canal Company v. Clark* (*supra*), the court said :

Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark.

The court of appeals, second circuit, also said :

No principle of the law of trade-marks is more familiar than that which denies protection to any word or name which is descriptive of the qualities, ingredients, or characteristics of the article to which it is applied. An exclusive right to the use of such a word as a trade-mark, when applied to a particular article, or class of articles, can not be acquired by the prior appropriation of it, because all persons who are entitled to produce and vend similar articles are entitled to describe them and to employ any appropriate terms for that purpose. (*Bennett et al. v. McKinley et al.*, 65 Fed. Rep., 505, 506.)

In *Columbia Mills Company v. Alcorn* (*supra*) the Supreme Court said:

(2) That if the device, mark, or symbol was adopted or placed upon the article for the purpose of identifying its class, grade, style, or quality, or for any purpose other than a reference to or indication of its ownership, it can not be sustained as a valid trade-mark.

And

The alleged trade-mark can not, for many reasons, be made the subject of an exclusive private property.

If that which is offered for registration is not a lawful trade-mark, then the party offering it for registration is not the owner and is not entitled to registration, and it is the duty of the Commissioner of Patents, under the trade-mark law, to refuse to register it.

The theory that there is no power under the trade-mark law to prevent an applicant from swearing his application through to registration over every obstacle of ownership or validity of the alleged trade-mark or its lawful use seems to be so unjust to the public as to be inadmissible. The Commissioner can not believe it to have been the intention of Congress, nor is it so expressed in the letter or spirit of the trade-mark law, that certificates of registration should be issued in defiance of notorious facts. The Commissioner can not believe that the law requires him to issue void certificates of registration in order to have the courts declare them void *pro forma*. Suppose facts which would void a certificate if one were to be issued were within the personal knowledge of the Commissioner, is he required by the trade-mark law to

issue the certificate? Is he to justify his action to the aggrieved public on the ground that he is a mere minister of their law, when that law itself declares that he "shall decide the presumptive lawfulness of claim to the alleged trade-mark"? The allowance of a certificate under such circumstances seems to be wholly irreconcilable with the mandatory requirements of the trade-mark law.

Another case which is instructive on the authority of the Commissioner of Patents to pass upon the question whether the thing offered for registration is a trade-mark is that of the *United States of America ex rel. Moodie v. Butterworth, Commissioner of Patents* (*supra*), decided by the supreme court of the District of Columbia on December 22, 1884, although this was not a trade-mark case. The facts in that case were these: Moodie filed in the Patent Office, as provided for by section 3 of the act approved June 18, 1874 (18 Stat. L., p. 78), amending the copyright law, an application for the registration of a certain alleged label. The examiner of trade-marks, to whom such applications are referred in the first instance for consideration, refused registration on the ground that the thing presented was not a label. Moodie then appealed from that ruling of the examiner of trade-marks to the Commissioner in person, who affirmed the examiner. (*Ex parte Moodie, supra.*) In passing upon the case the Commissioner said:

This case brings up before me for consideration two questions: First, has the Commissioner of Patents discretionary power under the statute to refuse to register as a label what, in his opinion, is subject-

matter only for a trade-mark? Secondly, if matter offered for registration as a trade-mark be not a trade-mark, by reason of non-adoption and use as such, may it therefore be registered as a label, although not coming within the known and recognized definition of the term label?

As to the first point, I am satisfied that Congress intended to devolve upon the Commissioner of Patents the duty of determining the character of the subject-matter offered for registration under the trade-mark and label law. Section 3 of chapter 301, Revised Statutes, contains the following clause: "Except that there shall be paid for recording the title of any print or label *not a trade-mark* six dollars," etc. The words "not a trade-mark" plainly indicate that some one must decide whether or not the proffered label is really nothing but a label. Who is to determine this? The same section says: "And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels," etc.

The trade-mark law of 1881, in section 3, speaks of the "alleged trade-mark." The whole tenor of the statutes is that the Commissioner of Patents shall determine the question of fact in executing the law, viz, as to whether or not the alleged trade-mark is actually a trade-mark; otherwise the office would be registering as trade-marks matter which the courts would unhesitatingly declare to be only labels, and vice versa. \* \* \*

If the office is to blindly accept the opinion of the applicant as to whether he has a trade-mark or a label, or be governed by his preference as to what he will call the subject-matter of the application, incidents of this sort must inevitably continue to arise, and the Patent Office would be in the unenviable position of deliberately misleading the public,

whose servant it is. In such an abstract matter as this there are likely to be many differences of opinion among persons unfamiliar with the law, however well settled the principles may be upon which a right decision must be based. The courts are sometimes confusingly loose in their language respecting trade-marks, classing as such what are 'really but labels. It would conduce, therefore, to greater uniformity and regularity in the practice of the office to have some one person decide whether or not an "alleged trade-mark" is actually what it is alleged to be. It seems to me that Congress so intended.

Moodie then applied to the supreme court of the District for a writ of mandamus to compel the Commissioner to register the label. The case was fully argued before the court, and the record shows that it was contended on behalf of the relator, Moodie—

that the courts alone have authority to finally determine whether an application for the registration of a label embraces a label or something else, and that the applicant's judgment on that question is conclusive upon the Patent Office.

It was, however, contended on behalf of the Commissioner that—

the Commissioner of Patents has the right, under the law, of refusing to register an alleged label on the ground that the application therefor does not embrace proper subject-matter for registration as a label.

The supreme court of the District of Columbia sustained the position taken by the Commissioner and dismissed the petition.

Section 3 of the act under which Moodie sought registration for his alleged label reads :

That in the construction of this act the words "engraving, cut, and print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the Commissioner of Patents, to the party entering the same.

There is not one word in this section or in any other part of the copyright law defining a label, yet the court sustained the contention of the Commissioner that he did not exceed his authority under the statute in deciding whether the thing presented for registration was a label. If the Commissioner is clothed with authority under the copyright law to pass upon and decide whether the thing offered for registration is a label, why is he not clothed with the same power under the trade-mark law, which provides that the owners of alleged trade-marks may have their marks registered, and which also provides that "in an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark."

The Commissioner looks to the statute creating his office and defining his duties for every power which he exercises, and when he reads therein that he "shall decide the presumptive lawfulness of claim to the alleged trade-mark," it seems to him that these positive words require him to investigate the question as to whether the thing presented is a trade-mark, whether it is such a mark as the applicant may claim for his exclusive use; in other words, decide the presumptive lawfulness of the claim.

It would seem to be a strange theory and construction of the trade-mark law to require the Commissioner to issue a certificate establishing *prima facie* ownership to a mark and guaranteeing protection of a mark under a state of facts which, were they made apparent to a court of law or of equity, would compel the court to pronounce the certificate void and worthless. It is said that the law never requires vain things to be done.

#### THE OLD AND NEW LAW RELATING TO THE REGISTRATION AND PROTECTION OF TRADE-MARKS COMPARED.

Section 4939 of the Revised Statutes, which is part of the trade-mark act of July 8, 1870, which the Supreme Court of the United States declared unconstitutional (*Trade-Mark Cases*, 100 U. S., 82), reads:

The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation, unaccompanied by a mark sufficient to distinguish

it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public. But this section shall not prevent the registry of any lawful trade-mark rightfully in use on the eighth day of July, eighteen hundred and seventy.

The relators admit that "this section unmistakably conferred upon the Commissioner of Patents the authority to refuse registration to trade-marks which were not in his judgment valid trade-marks." They make a comparison between section 3 of the present trade-mark act and section 4939 of the Revised Statutes, and argue that:

The act of 1870 specifically conferred the authority which the Commissioner now undertakes to exercise, but the empowering language of the act of 1870 is *omitted* from the act of 1881. The act of 1870 said:

"SEC. 4939. The Commissioner of Patents *shall not* receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark," etc.

This language is omitted from the corresponding section (3) of the act of 1881, which otherwise confers substantially the same powers upon the Commissioner which were conferred by the corresponding section of the act of 1870. Nothing could be plainer. When the Congress learned, through the decision of the Supreme Court, that it had no constitutional authority to create trade-mark

rights, it appropriately took away from the Commissioner of Patents the authority to pass upon the validity of trade-marks already in the stated commercial use, which alone are registrable under the new act.

An investigation of the subject will show that this contention can not be sustained. It is true that the exact words, "The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and can not become a lawful trade-mark," appearing in section 4939 of the Revised Statutes, were not embodied in section 3 of the present trade-mark act, but the full equivalent thereof, so far as relates to conferring upon the Commissioner of Patents the authority to refuse registry to trade-marks which are not in his judgment lawful trade-marks, is found in the words, "In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark," appearing in section 3 of the present trade-mark act. The words mean the same thing; the matter is simply differently phrased. It is true that under the old law marks intended to be adopted and used and which could become lawful trade-marks were registered, while under the present act only valid and lawful trade-marks, which have been adopted and actually used, can be registered, but this does not affect the question under consideration, nor is it affected by the fact that there is added to section 3 a clause directing what practice shall prevail in a dispute between an applicant and a registrant or between applicants.

## AMOUNT OF FEE.

It is to be noted that the amount of the fee which an applicant for registration of a trade-mark was required to pay into the Treasury was not changed in the new act, but remained the same as in the old law. If it was the intention of Congress to take away from the Commissioner the power and duty of examining applications for trade-marks and deciding whether the thing offered for registration is a valid and lawful trade-mark, why was the fee put at twenty-five dollars, the same as in the old law? Why require of an applicant the same fee under the new law if the Commissioner is not to investigate the question of ownership or validity or the lawfulness of the mark offered for registration if Congress intended to make the law a registration law, as contended for by the relators? If registration only were aimed at, why was not the same fee, a fee of one dollar, charged as for registering a copyright by the Librarian of Congress, or at least the amount of the fee reduced to six dollars, the same as required for the registration of a label in the Patent Office under the copyright statute? Why the exorbitant fee of twenty-five dollars for merely registering a trade-mark, while a fee of six dollars is charged for registering a label and only one dollar for registering a copyright?

Those who had in charge the bill that finally became the present trade-mark act, and who appeared before the committee in behalf of the bill, understood the situation. The trade-mark experts who appeared before the committee would not have permitted the fee to remain the

same if the Commissioner's authority and duty to examine into and decide the lawfulness of the trade-mark were to be taken away. They knew the difference between the amount of work necessary on an application which had to be examined under the law as to whether the thing offered for registration was a trade-mark and that required when a mark was merely to be registered without any such investigation. The amount of the fee remained the same under the new act, because the Commissioner was charged with the duty under such act to investigate and decide the right of the applicant to have his alleged trade-mark registered, and because this investigation would entail upon the Commissioner the same work that it did under the old law.

That the legislators thought that in making the present trade-mark law they were not making any such departure from the old law as here contended for by the relators, appears from the report by the Committee on the Judiciary, who had in charge the bill which became the present act. In that report it was said:

The bill seeks to reenact the trade-mark legislation of 1870 (Rev. Stat., secs. 4937-4947, inclusive), save that it is confined to foreign and interstate commerce. Its theory is that by thus separating them from interstate commerce the objections of the Supreme Court as to constitutionality will be removed.

\* \* \* \* \*

It reenacts the sections 4937-4947 of the Revised Statutes almost verbatim, except that its operations are confined to trade-marks used in commerce with the Indian tribes and foreign nations.

The relators in calling your honor's attention to the debate on this bill say :

The history of the trade-mark act of 1881 appears in these debates, as stated in our argument. There was originally a House Bill No. 2573, known as the "Armfield Bill." That bill, it is understood, was prepared by the officials of the Patent Office and Mr. Armfield. It in effect restated the law of 1870, basing it, however, upon the commerce clause of the Constitution, and providing also for a new office. The Committee on the Judiciary took this bill from the Committee on Manufactures, by order of the House, and substituted for it a new bill (H. R. No. 5088), which will be found at pages 184-186. This bill is the present law excepting that all after section 13 was cut out. It is radically different from the first bill, No. 2573, as a comparison of the two bills will indicate, and as is sufficiently evidenced for the present purpose by the statement of Mr. Armfield on page 241, in which he says that he disclaims all responsibility for the bill in its present shape. "It has been so altered by the committee that has had it in charge, both by leaving out what I put in and by putting in what I did not have in it and do not approve, that I must disclaim all responsibility for the paternity of the present bill."

The Committee on the Judiciary had already achieved its purpose by changing the whole character and scope of House Bill 2573 and substituting for it House Bill 5088. This bill 5088 Mr. Hammond and his associates were willing to have pass, providing the penal clauses were stricken from it, and they had so prepared the bill and report and directed the debate, that they could offer a trade-mark bill that was simply a registration bill ; so that

even if the penal clauses went through they would have little force or effect.

The relators further say :

Whether from lack of legal training, or with a purpose we do not know, the Act of 1881 was used in the Patent Office as if the first bill had passed. There is no force in this of "interpretation at the time," because the debates are so clear that he who reads may run.

It was, in short, a well-managed campaign against the principles of House Bill 2573; and now by inference the Commissioner assumes the same power he would have had if the "Armfield Bill," 2573, had become the law instead of being rejected by Congress.

It is true that Mr. Armfield introduced House Bill No. 2573, which was prepared by him and the officials of the Patent Office, and that it in effect, as stated by the relators, restated the law of 1870, and that the Committee on the Judiciary substituted for such bill the new bill, No. 5088, which became the present trade-mark act. It is also true that Mr. Armfield stated in debate :

I desire to disclaim all responsibility for the bill in its present shape. It has been so altered by the committee that has had it in charge, both by leaving out what I put in and by putting in what I did not have in it and do not approve, that I must disclaim all responsibility for the paternity of the present bill.

A reading of the full remarks of Mr. Armfield on the bill will show, however, that he was complaining of the action of the committee in limiting the bill to foreign commerce and commerce with the Indian tribes, instead

of extending registration to trade-marks used in interstate commerce. He was not complaining of the action of the committee in taking away any power from the Commissioner to examine applications for trade-marks and determine whether they are valid and lawful and should be registered.

The relators admit that the Armfield bill "in effect restated the law of 1870," and they also admit that the act of 1870 "unmistakably conferred upon the Commissioner of Patents authority to refuse registration to trade-marks which were not in his judgment valid trade-marks." When they admit these things they must admit that the present trade-mark law gives the Commissioner authority to refuse to register a trade-mark which in his judgment is not a valid and lawful trade-mark, for it will be shown that there is no difference between the bill reported by the committee and the Armfield bill, so far as this jurisdiction is concerned, and the statement of the relators that the bill which became the present trade-mark law "is radically different from the first bill 2573, as a comparison of the two bills will indicate," is absolutely wrong. So is their statement that "the Committee on the Judiciary had already achieved its purpose by changing the whole character and scope of House Bill 2573, and substituting for it House Bill 5088." No force and effect can be given to their statement that—

Whether from lack of legal training, or with a purpose we do not know, the act of 1881 was used in the Patent Office as if the first bill had passed. There is no force in this of "interpretation at the time," because the debates are so clear that he who reads may run.

It was, in short, a well-managed campaign against the principles of House Bill 2573; and now by inference the Commissioner assumes the same power he would have had if the "Armfield Bill," 2573, had become the law instead of being rejected by Congress.

Let us see what is in the Armfield bill which the relators admit is the same as the trade-mark law of 1870, and that under which the Commissioner has authority to pass upon the lawfulness of a trade-mark offered for registration. Section 1 of that bill merely created a new officer to examine trade-marks, but this was omitted from the bill because—

The committee know no good reason for the creation of a new office and new salary to accomplish this work. They perceive no good reason for taking this matter from the Patent Office.

This section of the bill, therefore, requires no further consideration.

Section 2 of the Armfield bill reads as follows:

Owners of trade-marks used in commerce with foreign nations, or among the several States, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country which by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements:

First. By depositing in the office of said registrar a written application specifying name, domicile, location, and citizenship of the party applying; the class of merchandise, and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a descrip-

tion of the trade-mark itself, with facsimiles thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used.

Second. By paying into the Treasury of the United States the sum of twenty-five dollars.

Section 4 of the Armfield bill reads :

The time of receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign or interstate commerce, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. In an application for registration the registrar shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases. From a final decision of the registrar a summary appeal shall lie to the supreme court of the District of Columbia sitting in banc.

A comparison of these two sections with sections 1 and 3 of the present trade-mark act will show that they are substantially the same as said sections 1 and 3, except that there is no provision under the present law

for recording trade-marks used in interstate commerce, and also that the appeal to the supreme court of the District of Columbia, provided for in section 4 of the Armfield bill, is omitted from section 3 of the present act. The reason for omitting that part providing for appeals is stated in the report of the committee as follows :

The appeal to the supreme court of the District of Columbia is omitted, because it is thought unnecessary.

Section 2 of the Armfield bill, it is seen, provides, as does section 1 of the present trade-mark act, that "owners of trade-marks," not *alleged* owners of *alleged* trade-marks, "may obtain registration of their marks," and section 4 also provides, as does section 3 of the present trade-mark act, that in an application for registration the officer who is to register the mark "shall decide the presumptive lawfulness of claim to the alleged trade-mark."

The other sections of the Armfield bill need not be here quoted, but a comparison thereof will show that they do not materially differ from the other sections of the present trade-mark law, except so far as they provided for the registration of trade-marks used in interstate commerce. Sections 3 and 5 to 13 inclusive, are substantially the same as sections 2 and 4 to 12, inclusive, of the present trade-mark act.

This, it is submitted, disposes of the relators' contention that the bill which became the present trade-mark law "is radically different from the first bill, No. 2573, as a comparison of the two bills will indicate," and

that "the Committee on the Judiciary had already achieved its purpose by changing the whole character and scope of House Bill 2573 and substituting for it House Bill 5088," and it is believed that they would not have made the statements that they did had they compared the two bills. Respondent fully agrees with the assertion of counsel for relators that "the debates" and, it may be added, the two bills themselves "are so clear that *he who reads may run*"—run away from the position taken by said counsel.

It is not proposed, however, to stop here in showing that the relators have no case. In addition to admitting that the Armfield bill "in effect restated the law of 1870," they admit that said bill "was prepared by the officials of the Patent Office and Mr. Armfield." It must be presumed therefore that the officials of the Patent Office knew what that bill covered and the authority it conferred upon the Commissioner of Patents. As has been shown above, there is no substantial difference between sections 2 and 4 of the Armfield bill and sections 1 and 3 of the present trade-mark act, under which the respondent contends that he has authority to refuse to register an alleged trade-mark, which, in his opinion, is not a valid and lawful trade-mark. Let us see, therefore, what interpretation the officials of the Patent Office have put upon the present act.

#### UNIFORM CONSTRUCTION.

Every Commissioner since the passage of the present trade-mark act has construed the act as giving him authority to examine an application and decide for himself

whether the thing presented for registration was a valid and lawful trade-mark, and when, in his judgment, the mark offered for registration was not such a mark as the courts would sustain, for the reason that the alleged mark was descriptive or geographical, or for any other reason, has refused to register it. This power and authority of the Commissioner to pass upon this question have been exercised for nearly twenty years. The first case involving this question was *ex parte Strasburger & Co.* (20 O. G., 155, C. D., 1881, 23), which was decided by Commissioner Marble, May 28, 1881. The facts in that case were these: Strasburger sought to register as the essential feature of a mark the representation of a locomotive, with the words "Railway Time-Keeper." The examiner refused to register the alleged trade-mark on the ground that the compound word *time-keeper* was descriptive in nature, and that the word *railway* was anticipated by a prior registration. With reference to the word *time-keeper*, Strasburger took the position that the objection to the descriptiveness of the proposed mark had no standing under the present trade-mark act and the rule adopted in conformity therewith. His argument was based upon certain changes which he alleged had been made in the phraseology of the present trade-mark act, the contention that has been made in the case at bar by the relators.

Commissioner Marble, after comparing the trade-mark law of 1870 with the present trade-mark act, said:

\* \* \* the present law makes no provision for the registration of prospective trade-marks, if they may be so called, or of trade-marks not in use in

foreign commerce; *but in other respects, as I read it, the law is unchanged.* I find in the passage quoted two prerequisites named as essential to a valid registration: First, that it shall appear that the proposed trade-mark is lawfully used as such; and second, that it shall appear that it is used in foreign commerce or in commerce with Indian tribes. It is clear that the oath of the applicant can not establish the existence of the first of these conditions, *where it appears upon inspection that a proposed trade-mark consists of words in general use, to which the applicant can have no exclusive right, or that the proposed trade-mark is not, in fact, a trade-mark in contemplation of the law.*

It is to be noted that this case was decided less than three months after the passage of the act and at a time when it would be fair to presume that the intent of Congress was fresh in the minds of the officials of the Patent Office who took part in the preparation of the Armfield bill, which, as has been shown, is substantially the same as the present act.

In the case of *Ex parte Kipling* (24 O. G., 889, C. D., 1883, 54), Commissioner Marble refused to register the word "Cristalline" as a trade-mark for artificial stones or brilliants, on the ground that the word was descriptive of the character of the goods to which it is applied, and in that decision he said:

While it is true that under the recent decisions of the supreme court of the District of Columbia the registration of a trade-mark by the Commissioner of Patents is to a large degree simply a ministerial duty, yet in the exercise of that duty it must be conceded that he has the right to refuse to register alleged trade-marks which are clearly not valid under the

decisions of the courts. It is still the duty of the Commissioner of Patents, I think, to inform applicants that signs, symbols, or words selected by them as trade-marks are not such, so that they may not be deceived in applying them to any class of goods. It is also his duty, I think, to the public to refuse the registration of an alleged trade-mark which would not be a valid trade-mark. Neither an applicant nor the public should be misled by the action of this office in accepting and registering words, signs, or symbols as trade-marks which are clearly not such.

The decisions of the supreme court of the District of Columbia referred to by Mr. Marble were reversed by the same court soon after the date of the decision in the Kipling case, and reference to the later decision of the supreme court of the District will be made further on in this brief.

While the case of *Ex parte Moodie* (*supra*), decided by Mr. Butterworth, Mr. Marble's successor, did not involve the question of the registration of a trade-mark but that of a label, yet the language used shows the attitude of Commissioner Butterworth on the question of the right of the Commissioner of Patents to decide whether the thing presented for registration should be registered. He says:

The trade-mark law of 1881, in section 3, speaks of the "alleged trade-mark." The whole tenor of the statutes is that the Commissioner of Patents shall determine the question of fact in executing the law, viz, as to whether or not the alleged trade-mark is actually a trade-mark; otherwise, the office would be registering as trade-marks matter which the courts would unhesitatingly declare to be only labels,

and vice versa. \* \* \* If the office is to blindly accept the opinion of the applicant as to whether he has a trade-mark or a label, or be governed by his preference as to what he will call the subject-matter of the application, incidents of this sort must inevitably continue to arise, and the Patent Office would be in the unenviable position of deliberately misleading the public, whose servant it is. In such an abstract matter as this there are likely to be many differences of opinion among persons unfamiliar with the law, however well settled the principles may be upon which a right decision must be based. The courts are sometimes confusingly loose in their language respecting trade-marks, classing as such what are really but labels. It would conduce, therefore, to greater uniformity and regularity in the practice of the office to have some one person decide whether or not an "alleged trade-mark" is actually what it is alleged to be. It seems to me that Congress so intended.

In *Ex parte Landreth* (31 O. G., 1441, C. D., 1885, 90) Commissioner Butterworth passed upon the question and decided that a red bag to be used for seed peas was not a valid trade-mark, and refused registration.

The question under consideration did not arise during the administration of Commissioner Montgomery, Mr. Butterworth's successor, so far as the reported cases show; but Mr. Hall, who succeeded Mr. Montgomery, had the question before him in the case of *Ex parte Bloch & Co.* (40 O. G., 443, C. D., 1887, 54). In that case applicant sought to register as a trade-mark the following words and arrangement:

The words "Knights of Labor" form the upper segment of a circle, the word "Whisky" forming

the lower segment. Within the circle as a central line are inserted the word and letters "K. of L.," above which, within the circle, is the word "Distillery," and below are the words "Sour mash." In the application it is stated that applicants have used this trade-mark continuously in their business in commerce with Germany since May, 1886, branding the same upon vessels containing distilled spirits and printing it upon invoices, bill-heads, cards, etc.

Commissioner Hall sustained the action of the examiner in refusing to register the thing presented, and in his decision said:

Prior to the act of Congress approved March 3, 1881, legislation provided for the registration of trade-marks already in use, as well as those intended to be adopted. But this was so far changed by the above act that the right to register was limited to trade-marks actually used at the time of application for the registration. Congress has never attempted to provide any definition of a trade-mark. Legislation in this particular has been of a negative character, limiting or restricting, declaring what may *not* be used. To determine what is a proper trade-mark and what may be registered, reference must be had to the common law as disclosed in the commercial usages and shown by the commentators and in the decisions of the courts.

In all the legislation of Congress upon the subject the requirement has been that the registry must be of a *lawful* trade-mark. The act of July, 1870, found in sections 4937-4946, Revised Statutes, though declared unconstitutional in the trade-mark cases (100 U. S., 82), has never been expressly repealed. It may well be doubted if section 4938, which affects the Commissioner of Patents only, is not still in force.

It expressly declares that the Commissioner shall not receive and record any proposed trade-mark which is not and can not become a *lawful* trade-mark, etc. The entire act expresses a clear inhibition upon the registry of an unlawful trade-mark or one calculated to deceive the public. The act of March 3, 1881, is equally clear:

"The Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark."

"SEC. 8. No action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained."

It must follow from the consideration of these and many other similar provisions of the statute that upon the presentation of each application for registry of a trade-mark it is the duty of the office to determine whether the proposed trade-mark is a lawful one.

Commissioner Mitchell, who succeeded Mr. Hall, exercised the authority conferred on him under the trade-mark law, and refused in the case of *Ex parte Proctor* (51 O. G., 1785; C. D., 1890, 97) to register the word "Cromarty" as a trade-mark for cured fish, on the ground that the word was geographical, and in his opinion could not be appropriated to applicant's exclusive use as a trade-mark, as others could with equal truth use the same mark upon packages containing the same article of merchandise.

In the case of *American Saw Company* (58 O. G., 521, C. D., 1892, 19) Mr. Simonds, the next Commissioner, also exercised his authority and refused to register

the word "Trenton" as a trade-mark for tools on the ground that it was geographical, saying:

This office should register no word as a trade-mark that has a positive geographical meaning, unless taught by some decision of a court or by some unusual state of facts that it has attained an arbitrary or fanciful meaning of greater substance and value than its mere geographical sense.

Assistant Commissioner Fisher, in the case of *Ex parte Stokes* (64 O. G., 437, C. D., 1893, 90), also exercised jurisdiction in passing upon the lawfulness of a trade-mark offered for registration, and refused to register the word "Splendid" as a trade-mark for flour, upon the ground that it was not arbitrary or fanciful. He said:

It is well settled that words and phrases which have been in common use and indicate the character, kind, quality, and composition of the article to which they are affixed can not be exclusively appropriated by any one. (*Canal Company v. Clark*, 13 Wall., 311; *Amoskeag Manufacturing Company v. Trainer*, C. D., 1880, 464; 17 O. G., 1217; 101 U. S., 51; *The Brown Chemical Company v. Meyer et al.*, C. D., 1891, 346; 55 O. G., 287.)

It is also well settled that no one has a right to appropriate a sign or a symbol or a name which, from the very nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. (See *Corbin v. Gould*, C. D., 1890, 295; 51 O. G., 622; 133 U. S., 308, and cases there cited.)

The construction placed by Mr. Seymour, the successor of Commissioner Simonds, on the trade-mark act is shown in the South Carolina case, already cited and discussed.

Mr. Butterworth, who was again made Commissioner after Mr. Seymour, again exercised his jurisdiction to pass upon the validity of an alleged trade-mark offered for registration, and in the case of *Ex parte Wolf* (80 O. G., 1271, C. D., 1897, 783) refused to register the word "Gyrator" as applied to bolting machines on the ground that it was descriptive.

The present Commissioner, the respondent here, succeeded Mr. Butterworth, and his construction of the statute is shown by the cases now before your honor.

These decisions of the successive Commissioners have been referred to and quoted from at length in order to show the court that no Commissioner since the passage of the present trade-mark act has confined his investigation to the four questions which the relators contend are the only questions the Commissioner is authorized under said act to investigate and decide, viz:

- (1) Lawful use in foreign or tribal commerce;
- (2) If it be the subject of a treaty, convention, or declaration;
- (3) If it be merely the name of an applicant;
- (4) If it be identical or substantially identical with a known or registered trade-mark of the same class owned by another.

These decisions show that every Commissioner since the passage of the said act has interpreted such act to give him authority to investigate and decide the question whether the thing offered for registration was a valid trade-mark—to decide the presumptive lawfulness of the claim to that mark—and when in his opinion the thing offered for registration was not a valid trade-mark, because it was geographical or descriptive or related to the

color of the package, or for any reason other than the four mentioned by the relators, he has refused registration.

It would seem that if there were any ambiguity in the trade-mark act there has been ample opportunity during the last twenty years to change it so as to make it clear; yet no attempt was made during all this time to amend the act. The present is an excellent time to amend the law, if amendment be needed, without upsetting the uniform practice of the office by a decision of the court, as the commission to revise and amend the statute relating to patents and trade and other marks, appointed under the act approved June 4, 1898, is now considering the question of the relation of the laws and is expected to make its report to Congress at an early date.

If there be any doubt as to the construction to be placed upon the trade-mark act, that doubt must be waived in favor of the uniform construction that has been put upon it by the successive Commissioners of Patents for the last twenty years.

It is a rule of law that:

Courts, in construing or interpreting a statute, give much weight to the interpretation put upon it at the time of its enactment and since by those whose duty it has been to construe, execute, and apply it; and especially is this true, where the statute is an ancient one and the construction that of cotemporaries who had special knowledge of the subject. \* \* \*

The contemporaneous and long-continued practice of officers required to execute, or take special cognizance of a statute, is strong evidence of its true meaning. (23 Am. and Eng. Enc. of Law, 339, 340.)

If your honor should have any doubt as to the meaning of the statute, that doubt must be waived in favor of the position taken by the Commissioner, as a mandamus will not lawfully issue except in a clear case. (High on Extraordinary Legal Remedies, par. 9, p. 11.)

Let us go one step further and assume, as the relators contend, that the trade-mark act is merely a registration act. Even in that case, it is submitted that the mandamus should not issue, for an examination of the authorities shows that the alleged mark "Ever-Ready" can not be held to be a valid trade-mark, and it is believed that the courts would hold it invalid as being merely descriptive of the character of the article to which it is applied, and that the relators have no exclusive ownership therein; that any other manufacturer or dealer in coffee mills may say with equal truth of his coffee mills that they are "ever-ready"—always ready for use.

The United States Supreme Court, as well as other courts, both in this country and in England, have repeatedly held that the mere announcement of a fact upon an article of manufacture or the use of a generic name or words to denote quality or character are not proper subjects for a trade-mark under the common law. (*Canal Company v. Clark*; *Bennett v. McKinley*; *Proctor & Gamble Company v. Globe Company, supra.*)

Exclusiveness of the right to use the mark is one of the essentials of a trade-mark, and when that is lacking there is no trade-mark.

Of a trade-mark it has been said:

There are certain infallible indicia of the nature of the symbol known to commerce and jurisprudence as a trade-mark. These are: 1. *Invariability*, i. e., fixed, positive, unmistakable; 2. *Individuality*, such a difference from other symbols as to indicate origin and ownership; 3. *Universality* of a right to its use, i. e., good as a representative of, or substitute for, the owner's signature all the world over; 4. *Exclusiveness* of the right to use; 5. *Application to merchandise*; 6. *Use in lawful business*; 7. *Truth and good faith*; 8. *Duration unlimited* but by the trade itself. (Browne on Trade-marks, sec. 143, p. 162.)

The case of the *United States ex rel. Everson v. Young, Librarian of Congress*, decided by your honor on April 12, 1898, vol. 26, The Washington Law Reporter, 546, applies to this phase of the case. In that case, as your honor will remember, a writ of mandamus was applied for to direct the Librarian of Congress to register a publication as a copyright which the Librarian held was not the subject of copyright, as it did not come fairly within the copyright act. Your honor said, after reviewing the law of mandamus:

So it seems to me that although it should be admitted that the act is mandatory and that the Librarian of Congress has no discretion in relation to the matter of recording, yet if he declines to record a copyright, a party applying will not be entitled to a writ of *mandamus* requiring him to act unless it appears that the publication comes fairly, or might come fairly, within the purview of the copyright act. I have examined the authorities referred to by counsel upon that question for the

purpose of determining whether this publication does in fact come within that purview, and, without entering into any discussion of the case, I think it is very clear that this proposed publication, which, as already stated, is only a book containing blank forms and does not contain a single English sentence—is not composition of any sort—does not come within the purview of the copyright law, and that if a *mandamus* should issue requiring the Librarian of Congress to record it under the copyright law, that act would be of no advantage whatever to the applicant for this writ. Any court would adjudge that it was not protected by the copyright law at all.

So, therefore, if a writ should issue in this case, it would be to require the Librarian of Congress to do a vain thing, which courts do not do in any proceeding, and much less on an application for *mandamus*.

To compel the Commissioner of Patents to register the compound descriptive word "Ever-Ready" as a trademark for coffee mills and to issue a certificate of registration, would be to compel the Commissioner to do a vain thing.

#### RELATORS' POINTS AND ARGUMENT DISCUSSED.

It would seem that enough has been said, and your honor's time would not be further occupied were it not for the fact that the question involved is so important that it is deemed advisable to answer specifically some of the statements made by the relators in their brief, even at the risk of repetition.

Point IV of relators' brief reads:

The scope of the act of 1881 is fundamentally different from that of the former act. Instead of

creating and regulating rights in trade-marks, it merely *authorizes their registration*. Instead of extending to merely intended or proposed marks, it permits only registration of marks already in use and in which the owner already has an existing property right, and therefore uses the words in the opening "*owners of trade-marks.*" Registration under the new act does not create any *right* which the owner did not previously have, beyond the privilege of suing a citizen of his own State in the United States courts when the defendant has wrongfully used the marks in foreign or tribal commerce. (See section 11.) Aside from this privilege of suing in a particular instance, the only effects of registration which are of advantage to the owner are that it is *prima facie* evidence of *ownership* (section 7), and that in some instances it is a necessary preliminary to foreign registration. The registration is thus a *notice* to the public of a *title* in the registrant, the only feature of value in the act, a feature which the Commissioner undertakes to arbitrarily curtail.

It is believed that the statement that "the scope of the act of 1881 is fundamentally different from that of the former act," and that said act merely authorizes the registration of trade-marks, has been fully answered. The contention that the present trade-mark act "permits only registration of marks already in use and in which the owner already has an existing property right" is not disputed; but to have that "existing property right" in a trade-mark, it must be an exclusive right, not a right that any other member of the public may have. (*Bennett v. McKinley*; *Proctor & Gamble Company v. Globe Company, supra.*) For this reason the statute says that "owners of trade-marks" may obtain regis-

tration and that the Commissioner "shall decide the presumptive lawfulness of claim to the alleged trade-mark." The statements that "registration under the new act does not create any right which the owner did not previously have, beyond the privilege of suing a citizen of his own State in the United States courts when the defendant has wrongfully used the marks in foreign or tribal commerce," and that "the only effects of registration which are of advantage to the owner are that it is *prima facie* evidence of ownership (section 7), and that in some instances it is a necessary preliminary to foreign registration" are denied by the act itself. Federal registration confers many rights that an owner of a trade-mark did not have previous to registration. As before stated, the advantages of registration are: It creates testimony, as registration is *prima facie* evidence of ownership in the trade-mark. Not only the certified statement, or specification, and the declaration, fix the title in the registrant as against any other claimant, thereby throwing the burden of proof on an adverse claimant, if such there be, but the certificate is evidence in any suit or action in which it is brought in controversy, and establishes the precise description of the symbol claimed, defines the class of merchandise to which the trade-mark is applied and affixed, fixes the date of adoption and use as to all the facts alleged, and obviates what would otherwise be a necessity, i. e., the production of oral testimony, and that at perhaps great inconvenience and expense. Registration is a means of effecting and effectuating treaty stipulations. It gives cognizance to courts of the United States in controversies

between inhabitants of the same State where a trade-mark used in foreign commerce is involved. By registration, original and appellate jurisdiction is given to those courts without regard to the amount in controversy. It gives a right to damages sustained in consequence of false representations made by a rival registrant. Registration has a strong moral effect in deterring infringements and in suppressing rival traders. The assertion of a Federal title of ownership gives an air of permanence and validity to the trade-mark and is eagerly sought for its moral effect "on the trade." Registration is an indispensable prerequisite to a criminal prosecution for counterfeiting, or selling goods falsely marked.

It is true, as stated by relators, that "registration is thus a notice to the public of a title in the registrant," and it may be, as relators contend on page 23 of their brief, that it is "wrong to hold an infringer except upon a published notice such as is given by proper registration." But it can not be successfully contended that when the United States issues a certificate which is to be *prima facie* evidence of ownership, and which gives an applicant such advantages and rights as above stated, the United States has no concern with the truth or falsity of the title claimed by applicant. Registration must be proper registration, but registration and notice to the public that applicant has a title when he has none do not constitute proper registration, but such registration and notice are a fraud and deception on the public. The Commissioner does not "arbitrarily curtail" any of relators' rights and privileges when he refuses to register the mark they have offered, because they are not owners

of the mark and have no such rights and privileges as they claim. The alleged mark is public property.

Under Point VI of relators' brief it is stated:

Since the act is limited to trade-marks in use in foreign or tribal commerce, the fact and lawfulness of such use are appropriately within the judicial jurisdiction of the Commissioner; and since the registration is *prima facie* evidence of ownership, the determination of ownership is likewise a proper function of that official.

It seems that when the relators admit that "the determination of ownership is \* \* \* a proper function" of the Commissioner of Patents they admit themselves out of court. If the thing offered for registration is such a thing as all persons have the right to use, if it is in the public domain, relators can not monopolize it as a trade-mark. In determining what is a trade-mark, it necessarily follows that ownership must be investigated and determined, for, as has been shown above, exclusiveness of the right to use is one of the essentials of a trade-mark, and when that is missing there is no trade-mark and no one has the right to registration.

It is stated in Point XI that—

In the case at bar the Commissioner does not allege defect as to any of the *requirements* of the law, nor that there is any rival claimant.

It is true there is no rival claimant, and if by the statement "the Commissioner does not allege defect as to any of the requirements of the law" is meant that the relators have filed a formal application, the statement is correct. But the mere filing of an application does not

give a right to have a certificate of registration issued. That can be issued, as has been repeatedly here contended, only when the Commissioner is satisfied that the applicant is the owner of a lawful trade-mark.

It is not understood what relators mean by the statement under Point XII that—

The questions which the Commissioner has the authority to judicially determine have been decided in favor of relators.

They have not been decided in favor of relators by the Commissioner, the only officer who is charged under the trade-mark act with the duty of determining such questions.

Under Point XVII the relators make the statement that—

from the oral argument we understand that the Commissioner does not allege that this extraordinary authority is specifically conferred upon him, but he bases his jurisdiction only upon an *inference*.

This statement is inconsistent with that made under Point XVIII, where it is said:

The Commissioner's counsel rests entirely upon "presumptive lawfulness of claim to the alleged trade-mark."

The Commissioner does not and did not base his authority to refuse to register the alleged trade-mark claimed by relators upon inference. It has been contended on behalf of the Commissioner that by the words of section 3 of the trade-mark act specific authority is given to him to determine the question whether the trade-mark may be registered or not, and this section

was discussed on the oral hearing and your honor requested the relators to point out what they understood by the words "In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark."

Under Point XVII is the statement that "relators' rights are vested." It is denied that the relators have any right that any other person who desired to use this mark does not possess. Certainly they have no such vested, exclusive right to the use of the word as would entitle them to register it as a trade-mark, and without this exclusiveness the mark lacks one of the essential characteristics of a trade-mark. (Browne on Trade-Marks, sec. 143, p. 162.)

So much of the matter under Point XIX as needs any answer has already been disposed of, except the statement in relation to section 11 of the act of Congress approved July 24, 1897. This section reads :

That no article of imported merchandise which shall copy or simulate the name or trade-mark of any domestic manufacture or manufacturer, or which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any custom-house of the United States. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks to be recorded in books which shall be kept for that purpose in the Department of the Treasury, under such regulations

as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of such trade-marks; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs.

Of this section of the statute the relators say :

The act of Congress of July 24, 1897 (see p. 8 of the pamphlet copy of trade-mark laws published by the Commissioner of Patents), prescribes that domestic manufacturers may have recorded their trade-marks in books kept in the Treasury Department for certain stated purposes. Does this give the Secretary of the Treasury the power to determine judicially the validity of such marks? If the contention here made of the Commissioner of Patents is correct, the Secretary of the Treasury has this authority. Suppose the opinions of these two officials should differ, what would be the effect? Manifestly the Secretary of the Treasury has no such authority, and the Commissioner of Patents has no better basis for his assumed jurisdiction.

From this statement it is evident that the relators are not acquainted with the history, scope, and purpose of this act.

This section is substantially the same as section 2496 of the Revised Statutes, as embodied in the act approved March 3, 1883, which reads :

No watches, watch cases, watch movements, or parts of watch movements, or any other articles of foreign manufacture which shall copy or simulate the name or trade-mark of any domestic manufacture [manufacturer] shall be admitted to entry at the custom-house of the United States unless such do-

mestic manufacturer is the importer of the same; and in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks to be recorded in books which shall be kept for that purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department *facsimiles* of such trade-marks; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs.

It is to be noted that the act provides that "any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks to be recorded in books which shall be kept for that purpose in the Department of the Treasury, *under such regulations as the Secretary of the Treasury shall prescribe.*" To carry out the provisions of that act the Treasury Department, on May 15, 1883, issued a circular, addressed "To collectors of customs and others," in which it was stated that—

Applications for the recording of names or trade-marks in this Department will mention the name and residence of the domestic manufacturer and furnish a description of the mark. *No such name will be received unless recorded in the Patent Office, as mentioned in chapter 2, Title LX, Revised Statutes, and the fact must be shown by the production of a copy of the mark, certified by the Commissioner of Patents, under the seal of the Patent Office, in the manner set forth in said chapter, and also of the necessary facsimiles, under the seal of the Patent Office, to be forwarded to collectors of customs.*

Here is a regulation of the Secretary of the Treasury prohibiting the registration of a name or trade-mark in the Treasury Department under that act, unless the Commissioner of Patents was satisfied that said name or mark was a lawful trade-mark. Evidently he was of opinion that he had authority under the act to make such a regulation and determine or have determined for him by the Commissioner of Patents the validity of the mark to be registered in the Treasury Department. Under these conditions there was no danger that these two officials would differ in their opinion as to what should be registered under either act. But what if the opinion of these two officials should differ? There has been such a thing as courts differing in their opinion on questions brought to them for consideration. The authority of the Secretary of the Treasury to make such a regulation as just referred to was never questioned.

It seems that the law providing for depositing names and marks in the Treasury Department was intended to prevent unfair competition of importers of merchandise manufactured abroad, which bore such a name or mark as would induce the public to believe that the said merchandise was made in the United States. Under this law many marks that could not be registered in the Patent Office, because they are not lawful trade-marks, might be protected to the extent of preventing certain persons from using them, on the ground that said persons used them deceptively and in unfair competition.

On representation to the Secretary of the Treasury that the legal conditions precedent to registering a trade-mark in the Patent Office were a bar to the recording

of a number of names and marks in the Treasury Department, the Secretary of the Treasury modified the regulation of the Treasury Department so as to admit to deposit for the purpose of the law any name or mark upon the sworn statement of the party who desired the name or mark to be recorded in that Department. The regulation reads to-day :

Applications for the recording of names or trade-marks in this Department will state the name and residence of the domestic manufacturer, and furnish a description of the mark and the names of the ports to which the facsimiles should be sent. No such name or trade-mark will be received unless accompanied by the proper proof of ownership, and proof that the owner is a domestic manufacturer, which must consist of the affidavit of the owner, or one of the owners, certified by a notary public, or other officer entitled to administer oaths, and having a seal.

The Treasury Department requires no fee for recording the name or mark ; it issues no certificate of registration, as is done by the Commissioner of Patents under the trade-mark act, and no such rights are conferred upon the party who has the mark recorded in the Treasury Department as are conferred upon the owner of a trade-mark who has it registered in the Patent Office. The recording of a name or mark in the Treasury Department does not give to the depositor a *prima facie* title nor a standing in court. The mere name of an applicant may be recorded in the Treasury Department, while it can not be registered in the Patent Office under section 3 of the trade-mark act, and the use of such a name by

another party unlawfully would be restrained, under certain circumstances, not on the ground that the party recording it has the exclusive right to the use of that name, or that it is a trade-mark, but on the ground of unfair competition. See *Baker & Co. v. Sanders* (80 O. G., 1476; C. D. 1897, 820) and cases therein cited; *Pillsbury Company v. Eagle* (85 O. G., 1397; C. D. 1898, 675). See also in this connection *Anheuser-Busch Brewing Association v. Piza* (32 O. G., 1123; C. D. 1885, 404) and paragraph 43, page 50, Browne on Trade-Marks.

On pages 23 and 24 of relators' brief is found this statement:

In our opinion it would be quite as well in point for a recorder of deeds to decline to register a deed on the ground that the measurements were not correct, or for a register of wills to refuse to record a will on the ground that in his opinion it granted an estate in perpetuity. In such actions those officers would be clearly usurping the authority of the courts, and in the same way the Commissioner of Patents is going beyond the authority vested in him by Congress, and is reaching into the domain of the courts, where Congress declined to go.

This is the same argument that was advanced by the relator in the South Carolina case, *supra*. Of it the court of appeals said:

We think it plain that the duties of the Commissioner are something more than ministerial and that they differ widely from the duties of a mere register of deeds or receiver of papers for file, with which an attempt has been made to institute a comparison.

Furthermore, can it be successfully contended that the court would command the recorder of deeds or register of wills to record a paper offered for record which by the authorities is clearly not a deed or a will?

The court did not command the Commissioner of Patents to record under the copyright law a thing which the Commissioner held to be not a label. (See the *Moodie case, supra.*) Your honor did not command the Librarian of Congress to record a thing which was not subject for copyright. (*United States ex rel. Everson v. Young, Librarian of Congress, supra.*) It is believed the court will not command the Commissioner of Patents to record as a trade-mark in the Patent Office the word presented in this case.

#### AUTHORITIES CITED BY RELATORS.

On page 24 of relators' brief are cited two cases which they use as authorities distinguishing the duties of the Commissioner as a judicial officer and as a registering officer. The latter case they rely upon as showing their right to have the mandamus issued as prayed for. In referring to these two cases they say:

The distinction between the Commissioner of Patents as a judicial officer in treating inventions and a registering officer to record trade-marks is illustrated in the opinions of the supreme court of the District of Columbia in *United States ex rel. Horace Koechlin and Otto N. Witt vs. Edgar M. Marble, Commissioner of Patents* (1882), 22 O. G., 1365, and *United States ex rel. The Willcox & Gibbs Sewing Machine Company vs. E. M. Marble, Commissioner of Patents*, 22 O. G., 1366 (1880) [1882].

The first case need not be discussed, as it is admitted that "it was apparent that the Commissioner of Patents was acting within the authority of Congress." The second case, however, needs to have some light thrown on it. It is presumed to be the case to which Commissioner Marble referred in *Ex parte Kipling, supra*. In the first place, the statement of the relators that it was a trade-mark case is erroneous. That case did not arise under the trade-mark law, but under the copyright law. In that case the Willcox & Gibbs Company claimed the right under section 3 of the act of June 3, 1874, amending the copyright statute, referred to and copied above, to have what they claimed to be a label registered in the Patent Office. The Commissioner refused to register the alleged label on the ground that the thing offered for registration was not a label, but a trade-mark. The court issued the writ, and in their decision held, as stated by the relators here, that "when an applicant for registry complies with all the requirements of the law and the lawful regulations \* \* \* the function of the Commissioner is merely ministerial." These words refer solely to the duty of the Commissioner to register a label, and not to his duty in the matter of registering a trade-mark, as the brief of relators would lead one to believe. A further examination of the records of that case shows that it was substantially an *ex parte* proceeding before the court which issued the writ, the Commissioner not being represented, and that it was not fully argued. Unfortunately for the relators here, at any rate, the doctrine laid down in that case was overruled soon after by the court

which announced it, in the case of *United States ex rel. Moodie (supra)*, involving the same question, after full argument and presentation.

In the Moodie case the question was squarely put to the court for determination whether the Commissioner of Patents had the right, under the law, to refuse to register an alleged label on the ground that the application therefor did not embrace proper subject-matter for registration as a label. It was argued on behalf of Moodie that the courts alone have authority to finally determine whether an application for the registry of a label embraces a label or something else, and that the applicant's judgment on that subject is conclusive on the Patent Office. The court, however, took a different view from that contended for by the relator Moodie and refused to grant the petition, as the court record will show and as also appears from the notice of said case on page 1, C. D. 1885.

So it appears that the very case and the only case which the relators have been able to find and upon which they rely to support their contention advanced in this case has been overruled and is not law to-day.

#### CONCLUSION.

In conclusion it is respectfully submitted that the trade-mark act invests the Commissioner of Patents, and only the Commissioner, with the duty of determining whether an alleged trade-mark offered for registration is a lawful trade-mark and should be registered in the Patent Office.

It is also submitted that the duty of the Commissioner of Patents under the trade-mark law, in registering an alleged trade-mark, is not "one in respect to which nothing is left to discretion," nor is it "a simple, definite duty, arising under conditions admitted or proved to exist and imposed by law."

It is further submitted that the court of appeals of the District of Columbia in the South Carolina case has definitely determined that the trade-mark act has imposed upon the Commissioner of Patents the duty of determining whether in his opinion the thing offered for registration is a lawful trade-mark and should be registered, and that the Commissioner's opinion, whether right or wrong, can not be controlled by the court on a petition for mandamus.

It is further submitted that were this court in doubt as to the construction to be placed on the trade-mark act in the matter of imposing upon the Commissioner the duty of determining for himself whether the thing offered for registration is a lawful trade-mark and should be registered, said doubt must be waived in favor of the respondent in view of the interpretation that has been put on the act since its passage, and the writ of mandamus should not issue as prayed for.

It is further submitted that even if it should be held that the duty of the Commissioner in the matter of registering trade-marks is merely ministerial, a mandamus should not issue in this case, in view of the law of mandamus, as stated in the case of *United States ex rel. Everson v. Young (supra)*.

It is finally submitted that the rule to show cause why peremptory mandamus should not be issued should be discharged and the petition dismissed with costs.

W. A. MEGRATH,  
*Counsel for Respondent.*

FEBRUARY 24, 1900.

## APPENDIX A.

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FEBRUARY 13, 1900.

MR. JUSTICE COLE.

DEAR SIR: In the trade-mark cases I have advised Mr. Megrath that I shall send you a copy of the "Preliminary Report" referred to in our argument.

I call attention particularly to the debate, pages 183-245.

The history of the trade-mark act of 1881 appears in these debates, as stated in our argument. There was originally a House Bill, No. 2573, known as the "Armfield Bill." That bill, it is understood, was prepared by the officials of the Patent Office and Mr. Armfield. It, in effect, restated the law of 1870, basing it, however, upon the commerce clause of the Constitution, and providing also for a new office. The Committee on the Judiciary took this bill from the Committee on Manufactures, by order of the House, and substituted for it a new bill, H. R. No. 5088, which will be found at pages 184-186. This bill is the present law, excepting that all after section 13 was cut out. It is radically different from the first bill, No. 2573, as a comparison of the two bills will indicate, and as is sufficiently evidenced for the present purpose by the statement of Mr. Armfield on page 241, in which he says that he disclaims all responsibility for the bill in its present shape. "It has been so altered by the committee that has had it in charge, both by leaving out what I put in and by putting in what I

did not have in it and do not approve, that I must disclaim all responsibility for the paternity of the present bill."

These debates bear out forcibly our statement that there was a strong feeling in Congress that that body had no constitutional power to provide a trade-mark law as such. So strong was this view that Mr. McCoid offered a constitutional amendment which is quoted at page 196, and urged by Mr. McCoid in the debate, pages 202-245.

Mr. Hammond, of Georgia, led the debate against the constitutional amendment, against the penal clauses (which were afterwards stricken out), and practically against what would have been a Federal trade-mark law—that is, an attributive law. The Committee on the Judiciary had already achieved its purpose by changing the whole character and scope of House Bill 2573, and substituting for it House Bill 5088. This bill 5088 Mr. Hammond and his associates were willing to have pass, providing the penal clauses were stricken from it, and they had so prepared the bill and report and directed the debate that they could offer a trade-mark bill that was simply a registration bill; so that even if the penal clauses went through they would have little force or effect.

Nothing could be clearer than the evident purpose of the committee that no Federal trade-mark law should pass. On the other hand there was a strong body which believed that no trade-mark law of any sort should pass except upon the basis of a constitutional amendment. A large majority of the House were thus clearly against what might be termed a Federal trade-mark law, and this majority succeeded, and passed as a substitute the registration law of House Bill 5088, now the law of 1881.

Whether from lack of legal training or with a purpose we do not know, the act of 1881 was used in the Patent

Office as if the first bill had passed. There is no force in this of "interpretation at the time," because the debates are so clear that he who reads may run.

It was, in short, a well-managed campaign against the principles of House Bill 2573; and now by inference the Commissioner assumes the same power he would have had if the "Armfield Bill," 2573, had become the law, instead of being rejected by Congress.

I can not let this opportunity pass of adding two points to the brief filed for the Bronson Company in the "Ever-Ready" case.

What is the Commissioner saving to the public? The right to use a mark he thinks bad? That is, does he maintain that the public has a right to use this mark as a trade-mark, and that, therefore, no individual can claim it? Any other defense of public rights becomes too vague and general to have any place in the scope of executive function.

In the present practice of the office applicants go in and pay a generous fee on a particular mark to be rejected. The application then lies dormant and unpublished. Would it not be a better protection of the rights of the public if the first applicant for such mark had it registered, so that it stood in the public records where a tyro, even, could find it, and so that the subsequent users could have fair warning that someone had preceded them? Nothing else is so effective against the use of a mark as the notice of a prior use by someone else, and such notice is a direct and positive benefit to the public as against the vague and general possibilities of danger to the public which seem to haunt the mind of the Commissioner—that is, the register of trade-marks.

A copy of this goes to Mr. Megrath, counsel for the Commissioner, previous to the conclusion of his brief, and is forwarded with his consent.

Very respectfully,

WALTER F. ROGERS.

## APPENDIX B.

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In the House of Representatives, December 9, 1879.

(H. R. 2573.)

Mr. ARMFIELD, by unanimous consent, introduced the following bill:

A BILL to authorize registration and protection of trade-marks.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,*  
That there shall be in the Department of the Interior an officer learned in the law, to be called the registrar of trade-marks, who shall be appointed by the President of the United States, by and with the advice and consent of the Senate, and shall be entitled to a salary of three thousand five hundred dollars a year, to be paid monthly.

SEC. 2. Owners of trade-marks used in commerce with foreign nations, or among the several States, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements:

First. By depositing in the office of said registrar a written application specifying name, domicile, location, and citizenship of the party applying; the class of merchandise and the particular description of goods com-

prised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, with fac-similes thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used.

Second. By paying into the Treasury of the United States the sum of twenty-five dollars.

SEC. 3. The application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce, as above indicated, and other than that which is wholly between citizens of the same State; and that the description and fac-similes presented for registry truly represent the trade-mark sought to be registered.

SEC. 4. The time of receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign or interstate commerce, as above-mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. In an application

for registration the registrar shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases. From a final decision of the registrar a summary appeal shall lie to the supreme court of the District of Columbia, sitting in banc.

SEC. 5. Certificates of registry of trade-marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the Secretary of said Department and countersigned by the registrar of trade-marks, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade-marks and of statements and declarations filed therewith, and certificates of registry so signed and sealed, shall be evidence in any suit in which such trade-marks shall be brought in controversy.

SEC. 6. A certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country, by virtue of [their] act, at the time that such trade-mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years, such registration may be renewed on the same terms and for a like period.

SEC. 7. Applicants for registration under this act shall be credited for any fee, or part of a fee, heretofore paid by them into the Treasury of the United States with intent to procure protection for the same trade-mark.

SEC. 8. Registration of a trade-mark shall be prima facie evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration, shall be liable to an action on the case for damages for the wrongful use of said trade-mark, at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign or interstate commerce, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act, and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

SEC. 9. No action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

SEC. 10. Any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the registrar of trade-marks, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case.

SEC. 11. Nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.

SEC. 12. Nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported from one State to another State for the purpose of commerce, or to a foreign country, or in lawful commercial intercourse with an Indian tribe.

SEC. 13. The registrar shall prescribe rules for assignments of duly registered trade-marks and the recording thereof in his office.

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